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IN THE

upreme Court of the United States

October Term, 1972.

No. 72-423

HADCO PRODUCTS, INC.,

Petitioner,

v.

WALTER KIDDE & COMPANY,

Respondent.

TITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT.

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Respondent.

ITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT.

he Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your Petitioner, Hadco Products, Inc., a Pennsylvania oration, prays that a Writ of Certiorari be issued to w the Judgment of the Court of Appeals for the Third uit entered on June 16, 1972 and amended July 28,

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I. ORDERS, OPINIONS AND JUDGMENTS BELOW.

(a) Opinion (No. 19068) and Judgment of the Court of Appeals for the Third Circuit, June 16, 1972, — F. 2d —, and Amended Judgment entered July 28, 1972.

(b) Opinion and Order of the District Court for the Eastern District of Pennsylvania, April 2, 1970, 313 F. Supp. 1172.

(c) The patent here in suit was also before the United States District Court for the District of New Jersey in *Hadco Products, Inc. v. Frank Dini Co., Inc.*, 401 F. 2d 462 (3 Cir., 1968).

II. STATEMENT OF THE GROUND ON WHICH JURISDICTION OF THIS COURT IS INVOKED.

(a) This is a suit arising under the patent laws of the United States, Title 28 § 1338, of the United States Code.

(b) The jurisdiction of this Court is invoked under Title 28 § 1254 of the United States Code.

(c) The Judgment which the Petitioner seeks to have reviewed herein was entered June 16, 1972 and amended July 28, 1972. No petition for rehearing was filed.

III. QUESTIONS PRESENTED FOR REVIEW.

(a) Is design patent No. 199,143, which was held valid by the District Court and invalid by the Court of Appeals, valid?

(b) Can any design patent be valid within the Court of Appeals construction of *Graham v. John Deere Co.*?

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IV. STATEMENT OF THE CASE.

Howard Daum, the patentee, has spent his entire life in the design and creation of ornamental lighting fixtures.

As a young boy in 1925 he worked in his father's lighting fixture firm, first as draftsman and then as designer. He studied drawing and design and subsequently designed and created ornamental lighting fixtures for many lighting firms throughout the country.

In 1955 Howard Daum established his own company for the design and creation of ornamental lighting fixtures. Employing his own initials as an acronym, he named his company Hadco Products, Inc. Howard Daum's principal occupation in his firm continued to be the designing and creating of ornamental lighting fixtures. From the formation of Howard Daum's company it enjoyed a continuously increasing patronage based almost entirely upon the designs for ornamental lighting fixtures which he created.

While many of Howard Daum's designs enjoyed success in the market consonant with the progress of his firm's business, the ornamental lantern of the design patent in suit enjoyed immediate and outstanding acceptance in the trade of an order of magnitude far exceeding the general acceptance of his other designs. The phenomenon was well established before the design patent was issued by the Patent Office on September 15, 1964.

The design Howard Daum patented was for a lantern suggestive of the old English or Tudor period but which avoided the characteristic formality and austerity of that period by the ingenious use of graceful and simple lines. Surprisingly, it had the effect of rendering the lantern compatible with widely differing types of architecture, traditional or modern. According to undisputed testimony, it was found to have a universality of application, i.e.,

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suitability for use in different environmental settings, lacking in the prior art.

At the time of the introduction of the patented Hadco ornamental lantern, Progress Manufacturing Company, Inc.,[1] calling itself the world's largest manufacturer of lighting fixtures, carefully and deliberately copied the design using an actual Hadco ornamental lighting fixture as the model. Within six months after Hadco's first sale, Progress obtained a Hadco leaflet illustrating the design, acquired a physical specimen of the Hadco lantern, and decided, in response to customer demand, to produce the identical Hadco ornamental fixture. It first attempted to purchase the Hadco firm outright. Failing in that, it copied the Hadco ornamental lantern in minute detail and placed it on the market, where it enjoyed substantial success similar to the success enjoyed by the original patented lantern of Howard Daum.

This suit was filed against Progress on October 15, 1965. After extensive discovery, the trial was held before District Judge Ralph C. Body. During the fifteen days of the trial, Judge Body heard many witnesses, including the inventor Howard Daum, and various experts. A deposition of the designer for Progress who appropriated the Daum design was read in open court. Numerous documentary and physical exhibits were made available, including a full exposition of patents and catalogs evidencing the state of the art.

On April 2, 1970 Judge Body rendered his decision finding that the patent satisfied the statutory requirements of 35 U. S. C. § 103 in that "There are many characteristics of the patent in suit which set it apart from the prior art and which, when taken together, make it non-obvious to a person or ordinary skill in the art."

1. The suit was instituted against Progress Manufacturing Company Inc. which later merged into Walter Kidde and Company.

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In applying the legislative standard to the Daum patent, Judge Body acknowledged the controlling authority of the decisions of this Court in *Graham v. John Deere Co.*, 383 U. S. 1; 86 S. Ct. 684; 15 L. Ed. 2d 545 (1966); and *Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc.*, 396 U. S. 57; 90 S. Ct. 305; 24 L. Ed. 2d 258 (1969). He also pointed out the difficulty in applying these mechanical patent decisions to cases involving design patents (A33):

"Much of what was said in those cases is difficult to apply in design cases because of the inherent differences between design and non-design patents. The requirement of advancement, present in the constitutional standard of patentability, seems to have far less practical application in design cases."

Judge Body noted the decisions in *In re Laverne*, 356 F. 2d 1003; 53 C. C. P. A. 1158 (1966) and *In re Faustmann*, 125 F. 2d 388; 33 C. C. P. A. 1065 (1946), which outlined at some length the fundamental differences between design and utilitarian patents. He then went on to spell out the dilemma which a court faces in attempting to apply mechanical standards to design cases (A33):

"Moreover, if the Constitution requires that a patent advance or add to the sum of useful knowledge, how can any design patent be constitutional? For, how can a design add to the sum of useful knowledge when a disclosure is merely an artist's view of the device and the patent protection runs only to the ornamental features of the article and not the article itself? On the other hand, if merely a change in design is thought to satisfy the requirement of adding to the sum of useful knowledge, then the only test of patentability in a de-

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sign case is novelty. Some writers have suggested as much. In addition, the frame of reference with respect to the issue of obviousness in mechanical patent cases is utility, a concept admitting of essentially one definition. This is so because it is defined in terms of the common needs of the members of society. On the other hand, ornamentation or aesthetic appeal, the frame of reference in design patent cases, is largely a matter of personal taste which varies from individual to individual. Thus, one's feelings and conclusions about a design are to a considerable extent subjective."

The Court of Appeals for the Third Circuit heard argument on appeal on April 2, 1971 and fifteen months later on June 16, 1972 rendered its opinion reversing the decision of the District Court. Without questioning any of the District Court's underlying evidentiary findings of fact establishing the state of the prior art and the level of skill of the art, the Court of Appeals simply disagreed with the ultimate finding of fact that the design would not have been obvious to one having ordinary skill in the art.

The Court of Appeals gave considerable attention to the District Court's concern with the application of mechanical principles to design cases, going so far as to suggest that the existing dilemma should be resolved by Congressional action (A12):

> "The statutory scheme of equating the requirement of nonobviousness of a design patent with that of a mechanical patent renders the decision-making process far from simple, as is highlighted by the philosophical theories enunciated in *Laverne, supra*, and *Schwinn, supra*. And the complexity of current marketing practices may well call for a review of the la

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governing patents, both mechanical and design, but any basic change in present standards and requirements should be by appropriate legislative reform rather than judicial fiat."

It is impossible to find any objective basis upon which to distinguish the opposite conclusions reached by the District Court and the Court of Appeals in this case except for the District Court's willingness to consider against the broad background of the art the unique reception of the Daum design as one of a number of elements bearing upon the question of obviousness whereas the Court of Appeals rejected the history and impact of the design in the art as altogether irrelevant.

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V. REASONS FOR GRANTING THE WRIT OF CERTIORARI

1. In Finding Invalidity, the Court of Appeals in This Case Ignored the Evidentiary Results of the Trial, Including Exhibits and Reconstructed Testimony.

(a) The Trial Judge Painstakingly Applied the Criteria of the Patent Statute in Finding the Patent Valid.

Judge Body devoted fifteen days to the trial of the present case. The question of "obviousness" was the foremost issue at the trial, as is evidenced by the treatment of that subject in the Court's opinion. Judge Body recognized the applicability of § 103 of the Patent Act of 1952 and acknowledged the Court's mandate for the consideration of patentability in *Graham v. John Deere Co., supra* (Opinion of District Court, A29):

> "In addition, the Supreme Court has directed that an inquiry concerning obviousness take the following form:
>
> > 'Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.' "

Judge Body first reviewed the prior art in order to determine its scope and content, referring to the following prior art items all set forth in the Appendix to this Petition: 3 (A88), 6 (A90), 7 (A91), 16 (A93), 19 (A96), 21

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(A37). He then summarized the level of ordinary skill in the art as including the following (A32):

". . . the ability to design different lighting fixtures of somewhat varying styles having as their component elements a base, a cage, a roof, a vent cap, and a finial. Hexagonal cages of the type employed by Daum were known and commonly employed by other lighting fixture designers a number of years prior to the filing of his application for the patent in suit. Also, roofs corresponding in number of sides to the cage and exhibiting simulated ventilators set out from each panel thereof were a known quantity in lighting fixture design more than a year before the filing of this patent application. It is further true that such roofs were often conical in shape. Moreover, vent caps were commonly superimposed on the roofs of lighting fixtures, paralleling them in some aspect of design. Lastly, the devices of a finial and base were routinely used to complete the design and give it a sense of balance."

Judge Body found prior art items 4-7, 10-16, 21 and 11(a) to be "squatty and elongated designs" in sharp contrast to the Daum patent (A34). He found that prior art items 3, 4, 7-19, 21-22, were characterized for the most part "by a look of formality, of austerity quite foreign to the Daum design" (A34). He found that while the Daum design was "markedly different from the prior art in its adaptability to different geographical and environmental settings," (A34) the defendant "made no attempt to show that any item of the prior art is or was similarly adaptable" (A35).

Judge Body found that the prior art failed to show a lighting fixture presenting the "Christmas tree" effect of the Daum patent, even in the prior art items asserted for that purpose (A35).

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He then noted that the non-obviousness of the Daum patent over the prior art was "indicated in still another way" (A35). He found that the diligent efforts of the defendant to find similar fixtures among manufacturers in the lighting fixture trade had been singularly unsuccessful. He found that the Daum design satisfied a real need in the industry for a generally adaptable and versatile lighting fixture and that the defendant responded to the market success of the patented design by copying its features in detail.

In making the factual determinations leading to the conclusions of non-obviousness, the District Court clearly recognized that its primary responsibility was to evaluate the invention in the light of the prior art and that the other indicia of patentability were secondary, albeit "relevant to and supportive of [the] determination of non-obviousness" (A36). The Court acknowledged the admonition of the Supreme Court to "scrutinize combination patent claims with a care proportionate to the difficulty and improbability of finding invention in an assembly of old elements" (A38).

As the trial record shows, each of the items of prior art was the subject of testimony and documentary evidence which were submitted to careful scrutiny by the trial judge.

In delivering his decision, Judge Body analyzed the prior art item-by-item, summarized the prior art as evidence of the level of ordinary skill in the art and concluded that the invention taken as a whole would not have been obvious to a person of ordinary skill in the art, buttressing his conclusion with a series of evidentiary findings constituting indicia of non-obviousness.

It would seem that the manner in which Judge Body approached, considered and determined the question of obviousness was a classic example of precisely that ap-

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ordained in § 103 of the Patent Act of 1952 and by the Court in *Graham v. John Deere Co., supra.*

(b) The Court of Appeals Gave Scant Attention to the Evidence.

Fifteen months after argument of the appeal, the Court of Appeals rendered its decision reversing the judgment of the trial court. The Court first acknowledged that it was bound by the findings of the trial court under Rule 52(a) and then proceeded to make its own evaluation of the evidence from the cold record on appeal. In doing so on at least two distinct and critically important occasions, the Court of Appeals misread the exhibits and reconstructed the testimony.

One of the significant differences found by the trial court between the Daum design and the prior art was (A35):

> ". . . the sinusodially curved edges of the Daum roof, integrated with the triangular accents and scallops on the upper surfaces of the eaves, create a visual impression which is substantially different from and unanticipated by any combination of items of the prior art."

The Court of Appeals acknowledged Judge Body's detailed analysis of the prior art "which would support a finding of facial distinction between the Hadco lantern and the prior art as determined by the district judge on the basis of his visual impressions." But the Court of Appeals then went on to suggest, without saying so, that there was something wrong with the court's evaluation of that prior art in determining the non-obviousness of Howard Daum's design (A13-4):

> "But an ultimate conclusion of nonobviousness required an objective finding that similarity of appear-

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> ance was so lacking in the prior art as to render the Hadco design as a whole nonobvious to a worker of ordinary skill."

The Court of Appeals then offered its own description of the same essential prior art (A14):

> "The same findings are applicable to Kidde's Item No. 2, which portrays a six-sided lantern affixed outside a residential dwelling. The ribs of the cage ascend upwardly and outwardly toward the roof. It in turn carries out the hexagonal design, curving inward and upward substantially like Hadco's lantern, and is topped with a finial. The lower edge of the roof flares out slightly over the cage and appears to terminate in a scalloped design."

Note the Court's observation that the lower edge of the roof of Kidde's Item No. 2 "flares out slightly over the cage and appears to terminate in a *scalloped* design." Kidde's Item No. 2, which is page 17 of the 1940 Novelty Lighting Corporation Catalog, is reproduced on the next page in its actual size. To find that the lower edge of the roof of the lantern in that exhibit is flared out slightly over the cage and *appears* to terminate in a scalloped design would require more inventive genius than is required to sustain a patent.

Kidde's Item No. 13 comprising page 58 of the 1940 Novelty Lighting Corporation Catalog, a copy of which is presented on the following page, illustrates in much greater detail a lantern ostensibly the same as that shown in Kidde's Item 2. The detailed showing of the lantern relied upon as prior art is identified as Hex. Post Lantern No. 466. Interestingly enough, it was found by the Court of Appeals to *lack* the very scalloped design on the lower

Item No. 2, Page 17 of The
Novelty Lighting Corporation Catalog
55, dated 1940 (Ex. D142)

RESIDENTIAL LIGHTING

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Kidde's Item No. 13, Fixture No. 466-Hex. Post Lantern on Page 58 of Novelty Lighting Corporation Catalog 49, dated 1935 (Ex. D146)

466 - HEX. POST LANTERN
Base Dia. 5
Finish Old Copper
Glass Amber Mott

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edge of the roof which it imagined to exist in Kidde's Item No. 2 (A15):

> "The lower edge of its roof does not flare into a scalloped design, but instead terminates in a sheer vertical cut."

The Court of Appeals went on to buttress its erroneous observations of the prior art exhibits by quoting from testimony of Kidde's expert witness, Robert Stith, as follows (A16-7):

> "He stated that scalloped or rippled borders with indented triangular accents were frequently placed on the lower edges of roofs and vent caps; that vent caps were commonly designed to follow the contour of the roofs; and that it was common practice for designers to modify or reassemble the basic components of lanterns in various patterns, substituting curved or straight roofs, and adding or deleting simulated ventilators, vent caps and finials to suit customers' tastes."

The Court of Appeals failed to indicate the source of the above quotation except to indicate Mr. Stith's testimony generally. Stith's total testimony occupies only 34 pages of the 1576 page record. His comments on the prior art fall between pages A62 and A75 of the Appendix. *At no point did he state* that "scalloped or rippled border with indented triangular accents" were frequently placed on the lower edges of roofs and vent caps. What he did affirm was the use of "a sinuous curve" on the peripheral edge of a lantern roof and he also conceded the formation of "triangular indentations" but *he did not state* that they could be found in the prior art *together*. Nor did he state that it was "customary to substitute one or another of the ele-

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ments found in the prior art in any given design to suit the customer's taste."

In fact, it was brought out quite clearly on cross-examination that Mr. Stith's testimony as to what was common in the prior art added nothing to the specific prior art illustrations already in evidence (A80-1). It was further made painfully clear that Mr. Stith's testimony on direct examination, particularly that relating to his knowledge of the prior art, was developed by excessively leading questions of counsel (A66-A75):

> "Mr. Paul: Why not ask the witness questions instead of giving answers.
>
> "Mr. Seidel: I am just summarizing.
>
> "Mr. Paul: I know, but he is an expert in this field. You have qualified him as having a lot of experience.
>
> "Mr. Seidel: Okay. I won't summarize any more."

The trial judge quite clearly did not accept the uncorroborated undocumented "summary" of defendant's witness Stith. It is evident that the Court of Appeals chose to substitute its own judgment for the District Court's evaluation of the witness's testimony based upon the cold record on appeal. It is also clear that the Court read things into the exhibits and the testimony that are simply not there, leading to results at substantial variance with the evidence and the conclusions of the District Court, all contrary to the clear purpose and intent of Rule 52(a).

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(c) Both the District Court and the Court of Appeals Had Difficulty Applying the Mechanical Principles of *Graham v. John Deere* to a Design Patent.

In *Graham v. John Deere* the Supreme Court, dealing with a mechanical patent, went to great pains to set forth the procedures to be followed in determining the patentability of the invention. There was no suggestion in the opinion of the Court that the procedure should be applied rigidly to design patents. The District Court observed quite candidly that the Constitutional standard of patentability prescribed by the Court in *Graham v. John Deere* "seems to have far less practical application in design cases" and further went on to question under such a standard "how can any such design patent be constitutional." Judge Body did apply the customary approach used with all patents in that he carefully listed each feature of the Daum design known and commonly employed by other lighting fixture designers, as well as the features absent in the prior art. Not found in the prior art were the sinusoidally curved edges of the Daum roof integrated with triangular accents and scallops on the upper surfaces of the eaves which create a visual impression substantially different from and unanticipated by any combination of items of the prior art.

If the spirit of Section 103 be applied to design patents, then did not Judge Body fully comply? He dissected the prior art; he listed all features common to the prior art; he listed all features not found in the prior art; he then looked at the design as a whole and asked the question: Did Daum through an unobvious combination of old elements and new elements produce a pleasing ornamental effect not attributable to the individual parts but attributable to the manner in which they merged together to avoid the look of "formality and austerity", the "squatty" appear-

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ance, and the "elongated" effects of the prior art. In "sharp contrast" to the prior art, Judge Body found that Daum produced a lighting fixture "suggestive of old English architecture" and having a "Christmas tree" effect which "conveys a subtle sense of simplicity and gracefulness." With these findings bolstered by the phenomenal public acceptance of the Daum design surely all requirements of Section 103 were abundantly met.

The Court of Appeals acknowledged the dilemma posed by Judge Body by concluding that, although "equating the requirement of nonobviousness of a design with that of a mechanical patent renders the decision-making process far from simple" even to the extent that it "may well call for a review of the law governing patents, both mechanical and design" still any change from that flat prescription that the same test was to be applied in both cases "should be by appropriate legislative reform rather than judicial fiat." The Court of Appeals then went on to apply not only the mechanical formula of *Graham v. John Deere Co.*, but also the functional requirements enunciated by the Court in connection with the mechanical patent in *Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc.* to the effect that the elements of a combination "must create a synergistic effect" to be patentable.

The problem of finding "constitutional advancement of human knowledge" in designs which are purely ornamental and aesthetic, and of finding "synergistic" reactions among the elements of such designs, presents a challenge in metaphysics sufficient to boggle the mind of any judicial body. The District Court concluded that under a rigid application of mechanical criteria no design patent could ever be held valid and accordingly proceeded to apply its own judgment as to obviousness based upon the evidence before it. The Court of Appeals, with considerably less squeamishness, ignored the constitutional dilemma and

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found the patent invalid for lack of the *functional* virtues required by the recent Supreme Court decisions in *mechanical* cases.

1. The Courts of Appeal Are Using the Decisions of the Supreme Court in Mechanical Patent Cases to Extinguish the Design Patent System.

(a) Section 103 of the Patent Act of 1952 Was Motivated by the Congressional Reaction to Prior Supreme Court Decisions.

During the 1930's and 1940's the Supreme Court, in rendering a large number of patents unenforceable on various grounds, promulgated opinions which were construed by many as essentially an attack upon the patent system itself. In the circumstances of the time in which the decision of the Court was rendered in *Cuno Corp. v. Automatic Devices Corp.*, 314 U. S. 84; 62 S. Ct. 37; 86 L. Ed. 58 (1941) the requirement of a "flash of creative genius" as a basis for patentability was not looked upon as a mere rhetorical embellishment.[2] Jungersen's invention of precision casting in the 1930's presented the ultimate test of the Court's "flash of genius" standard which resulted in the invalidation of the patent in *Jungersen v. Ostby & Barton Co.*, 335 U. S. 560; 69 S. Ct. 269; 93 L. Ed. 235 (1948), by a divided Court. The patent had been held invalid in a divided decision of the Court of Appeals for the Second Circuit. The majority of the Court of Appeals struggled to bring the case within the "flash of genius" requirement of the Supreme Court, and pointed out that "recent Supreme Court pronouncements" had changed the significance of objective evidence of commercial acceptance in connection with patentability. Judge Learned Hand,

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2. See *Graham v. John Deere Co.*, *supra*, at 5.

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in dissent, also acknowledged that "the whole approach to the subject has suffered a shift within the last decade or so" but concluded that "The combination in suit has every hallmark of a valid patent." In his historic dissent from the decision of the Supreme Court, Mr. Justice Jackson agreed with the opinion of Judge Learned Hand and observed that "the only patent that is valid is one which this Court has not been able to get its hands on." The last significant pronouncement of the Court before the Patent Act of 1952 was the concurring opinion of Mr. Justice Douglas in *A. & P. Tea Co. v. Supermarket Corp.*, 340 U.S. 147; 71 S. Ct. 127; 95 L. Ed. 162 (1950), in which he excoriated the Patent Office for having "spawned" over a period of more than one hundred years a number of "incredible", "flimsy" and "spurious" patents which, being for mere gadgets "obviously have had no place in the constitutional scheme of advancing scientific knowledge." It is to be doubted that any design patent could survive the test of Mr. Justice Douglas' standard of patentability.

The Patent Act of 1952, while not changing the standard by which patents were to be judged, clearly removed from consideration the highly subjective legal test of "invention" which had been the device by which all patents had been held invalid, and substituted for it the factual, objective test of "obviousness." No one doubted that the "flash of genius" had been interred.

The Act of Congress of 1952 had a significant temporary impact upon the patentability of inventions. In the field of design patents alone, during the 10 years preceding the Patent Act of 1952, only one design patent had been held valid by a Court of Appeals. In the 10 years between the enactment of the statute and the decision in *Graham and John Deere*, nine design patents were held valid by the Courts of Appeals.

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(b) The Effect of Rigid Misapplication of the Mechanical Requirements of *Graham v. John Deere Co.* by the Courts of Appeals Is to Render All Design Patents Invalid.

In determining patentability of designs under the Patent Act of 1952 the Courts have traditionally placed substantial reliance upon objective evidence. Such evidence comprises the history of the art in which the invention was made, the progress or lack of same in that art, the need within the art for the benefit that the invention eventually produced and the manner in which the invention was accepted in the trade after it was produced. *Sanson Hosiery Mills, Inc. v. Glen Raven Knitting Mills, Inc.*, 189 F.2d 845 (4 Cir., 1953). An evaluation of invention typical of this approach was that set forth by Judge Learned Hand in his dissent in *Jungersen v. Baden et al.*, 166 F. 2d 807, 811 (2 Cir. 1948):

"If all the information was at hand, why was the new combination so long delayed? What better test of invention can one ask than the detection of that which others had all along had a strong incentive to discover, but had failed to see, though all the while it lay beneath their eyes?"

In *Graham v. John Deere Co.*, the Court for the first time considered the impact of the Patent Act of 1952 upon the validity of patents (page 17):

"Approached in this light, the § 103 additional condition, when followed realistically, will permit a more practical test of patentability. The emphasis on nonobviousness is one of inquiry, not quality, and, as such, comports with the constitutional strictures.

While the ultimate question of patent validity is one of law, *A. & P. Tea Co. v. Supermarket Corp.*,

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supra, at 155, the §103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy. See Note, Subtests of 'Nonobviousness': A Nontechnical Approach to Patent Validity, 112 U. Pa. L. Rev. 1169 (1964)."

While, in presenting its considered conclusion on the subject the Court did not state that the question of *obviousness* was merely a question of law, the statement that "the ultimate question of patent validity is one of law" has led many courts, including the Court of Appeals in the present case, to ignore all evidentiary findings of fact and treat the whole matter as a purely judicial inquiry regardless of the trial proceeding. Furthermore, the reference to the objective factors involving the history of the and the place of the invention in the art and its impact upon the art as "secondary considerations" has led many courts to treat these factors as irrelevant in the determination of obviousness, despite the Court's clear statements that they may have relevancy "as indicia of obviousness or nonobviousness".

As a result, we find many courts now sitting as super-patent-examiners, determining the validity or invalidity of

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design patents, not on the basis of evidence, but solely on the basis of their visceral reactions to the prior art.

In the case of mechanical patents, the specific utility of the invention, as compared with its predecessors, is susceptible of proof which as one factor can be weighed in determining obviousness. In design patents, however, the parallel requisite of "ornamentation" is not in itself susceptible of objective proof. The only objective evidence that can be presented to weigh upon the obviousness or non-obviousness of the design within a given art are those factors relating to the history and progress of the art and the impact of the invention. They are referred to as "secondary considerations" in *Graham v. John Deere Co.*

The net effect of the misapplication of the mechanical requirements of *Graham v. John Deere Co.* upon design patents has been that, in contrast to the nine design patents that were held valid in the ten years following the Patent Act of 1952, not one single design patent has been held valid by a Court of Appeals since the decision in *Graham v. John Deere Co.* Equally significant is the fact that of the eleven design patents that have been held invalid by the Courts of Appeals in that time, five were disposed of by summary judgment and four were cases in which the patents had originally been held valid and then reversed by the Courts of Appeals. In nine out of the eleven cases in which design patents have been held invalid since *Graham v. John Deere*, therefore, the decisions have been made completely independent of any judicial fact finding process.

3. The Time Has Come for the Supreme Court to Speak Up on Design Patents.

The Court has not adjudicated the validity of a design patent in more than seventy-five years, *Gorham Manufacturing Co. v. White*, 81 U. S. (14 Wall) 511, 524; 20 L. Ed.

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731 (1871); *Smith v. Whitman Saddle Co.*, 148 U. S. 674, 677; 13 S. Ct. 768; 37 L. Ed. 606 (1892). When those decisions were rendered by the Court there was an entirely separate section of the statute defining the patentability requirements for designs. The statute governing design patentability has been substantially changed since that time: May 9, 1902, Chapter 783, 32 Stat. 193; 1952, 35 U. S. C. 171.

In the intervening years numerous proposals have been made under which some means of protection for designs other than by Letters Patent would be afforded. The report of the President's Commission on the Patent System dated November 17, 1966 explicitly and flatly recommended that "all provisions of the Patent Statute for design patents shall be deleted and another form of protection provided." The Congress, however, has taken no action and there is no indication that any action will be taken.

While these proposals are dormant, the Patent System continues to function and the Patent Office continues to accept design applications and to issue about three thousand design patents every year to unsuspecting inventors who are led to believe that they are receiving protectable rights.

Reproduced in the appendix to this petition (A99-A107) are the published abstracts of design patents issued August 22, 1972 as they appear in the weekly issue of that date of the Official Gazette of the United States Patent Office. Even a cursory examination of this weekly sampling of design patents will show, as might be expected, that ornamental designs for the industrial arts are invariably made up of a combination of known design elements and involve no synergistic reactions except to the extent that the novel ensemble may present a particularly pleasing effect upon the eye.

It is not improper for the Executive and Congressional branches of our Government to consider proposals to eliminate patent protection for designs. It is improper, however, to attempt to accomplish this by judicial decree. If, as the recent decisions of the several Courts of Appeal would seem to indicate, no design patent can be sustained under the requirements of *Graham v. John Deere*, then the Court should either adapt the requirements of *Graham v. John Deere*, to accommodate design patents or the Court should make clear to the other branches of Government that designs are no longer patentable under our Constitution.

In any event, America's inventors, the Patent Office, the Courts and the public deserve an answer to the question raised by Judge Body in this case—how can any design patent be Constitutional?

Respectfully submitted,

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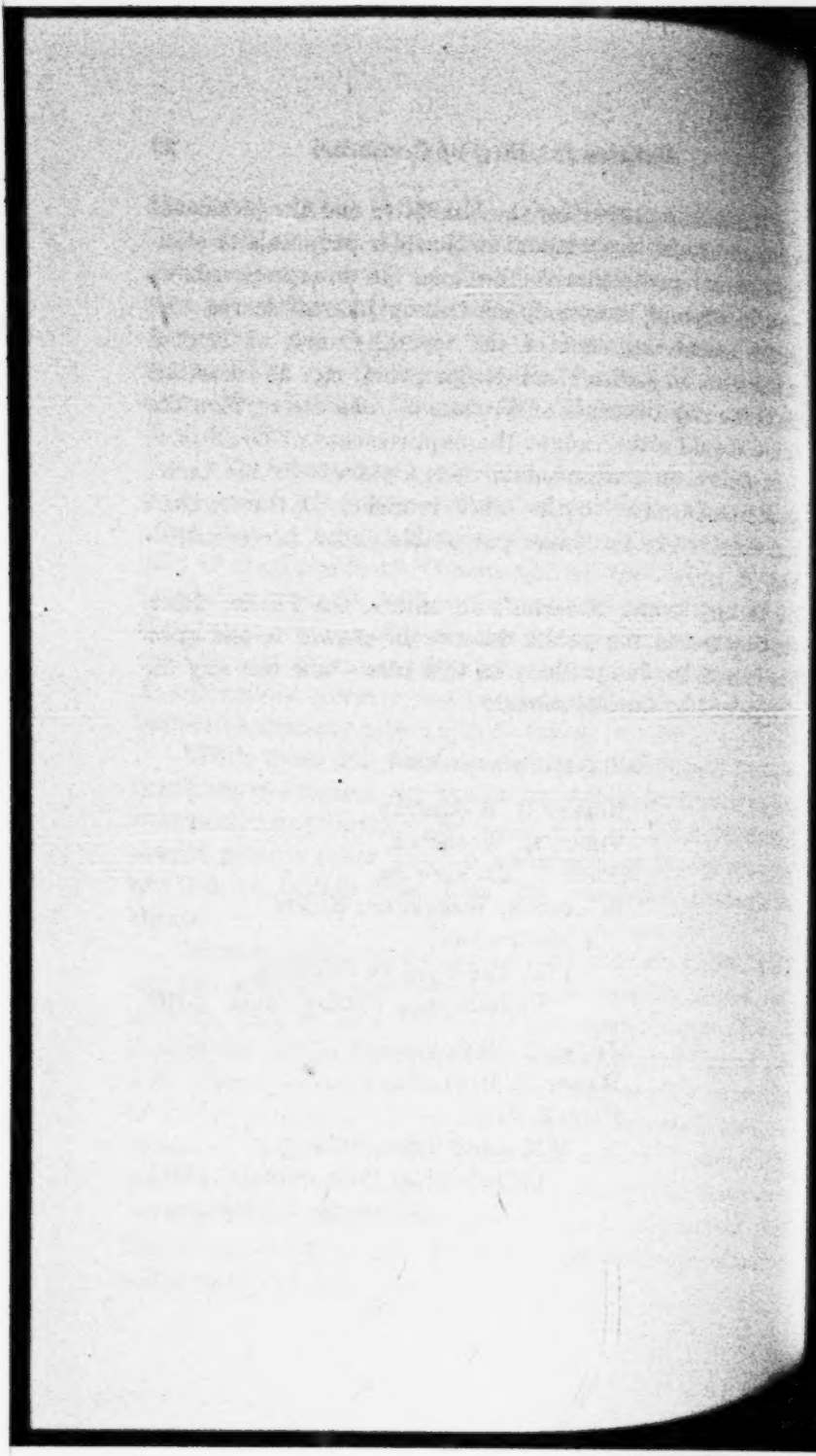

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IN THE

Supreme Court of the United States

72-423

October Term, 1972.

No.

HADCO PRODUCTS, INC.,

Petitioner,

v.

WALTER KIDDE & COMPANY,

Respondent.

APPENDIX TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT.

Supreme Court, U. S.
FILED
SEP 13 1972
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APPENDIX.

UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

No. 19,068

HADCO PRODUCTS, INC.

v.

WALTER KIDDE & COMPANY,

Appellant

APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

Argued April 2, 1971

Before FORMAN, SEITZ AND ALDISERT, *Circuit Judges*

OPINION OF THE COURT.

(Filed June 16, 1972.)

FORMAN, *Circuit Judge.*

This is an appeal from the Judgment of the United States District Court for the Eastern District of Pennsylvania of May 5. 1970 adjudging Design Patent 199,143

valid and infringed [1] by the appellant, Walter Kidde & Company, Inc. (Kidde).[2] The patent was issued to Howard A. Daum, who assigned it to the appellee, Hadco Products, Inc., (Hadco) a Pennsylvania corporation.

The patent in question is for a lighting fixture or lantern represented to be of Old English style, and advertised and sold as the "Tudor" by Hadco. It consists of a base, a cage, a roof, a vent cap, and a final as shown in the reproduction of the patent appended hereto.

The cage rests on a concavely-shaped cylindrical base, and forms a regular hexagon, which becomes wider as it ascends from the base to the roof. The roof in turn carries out the hexagonal design of the cage, curving inward and upward from the cage. Placed over the roof, the vent cap follows the inwardly curving silhouette of the roof and is also hexagonal. The bottom of both the roof and the vent cap flare out horizontally in a scalloped design topped with small triangular accents. The flared portion of the roof overhangs the cage as the equivalent portion of the vent cap overhangs the roof. In addition, the roof is decorated with six simulated ventilators, which are curved to its silhouette. At the top of the vent cap, a spike-shaped finial is set on a round, concave base.

This lighting fixture was conceived and designed by the patentee, Howard A. Daum, early in 1962, and appeared on the market through Hadco in August of that year. On

1. The Opinion of the District Judge is reported as *Hadco Products, Inc. v. Lighting Corporation of America, Inc.*, 312 F. Supp. 1173.

2. The appellee originally brought this action against the Lighting Corporation of America, Inc., a Pennsylvania corporation which had operated under the trade name of Progress Manufacturing Company until 1966 and was referred to as such by the District Judge in his opinion. After suit was instituted, the Lighting Corporation of America, Inc. merged with Walter Kidde & Company, Inc., a Delaware corporation, thereafter substituted as defendant-appellant herein.

April 25, 1963, he filed an application for a design patent. The application was amended three times[3] to make some changes and additions in the design, and a patent was issued by the Patent Office on September 15, 1964. It is conceded that the patent issued with several technical errors of draftsmanship.[4] Kidde began to sell the fixtures held to infringe the Daum patent in February of 1964.

All of the constituent parts of the Hadco lighting fixture are old and well known in the trade. Hadco concedes that the lantern is composed of a combination of elements commonly known and extensively used in the prior art. It argues, however, that the particular combination embodied in the "Tudor" design creates an unusual and aesthetically pleasing visual impression which is lacking in the prior art and discloses the lighting fixture as a novel work of creativity and inventiveness. Along this line, Hadco contends that the lantern fulfilled a long-felt but unsatisfied need for such a fixture in the industry. Here, as in the District Court, Hadco relies heavily on public acceptance of the lighting fixture, evidenced by the alleged great commercial

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3. The Patent Office did not require Mr. Daum to file a supplemental oath on his amendments which is necessary "[w]hen an applicant presents a claim for matter originally shown or described but not substantially embraced in the statement of invention or claim originally presented . . ." 37 C. F. R. 1.67(a). This implies that the Patent Examiner found the matter introduced by the amendments to be substantially embraced in the statement of invention. The addition of new matter to the disclosure of an invention by means of amendment is expressly prohibited under 35 U. S. C. § 132.

4. Among the errors alleged in the patent as issued were the following: the front view of the lighting fixture disclosed five simulated ventilators on the cage, whereas only three should appear if it represented a regular hexagon; the top view showed the simulated ventilators fully exposed, whereas they should be partially covered by the flaring, scalloped edge of the vent cap; and the triangular accents on the roof were of the same height in both the front and top views of the fixture, whereas the accents on the top view should have been smaller due to the principle of foreshortening.

success it has enjoyed, as proof of its originality, novelty and fulfillment of a long-felt need.

At the outset it is noted that the applicable standard of review in patent infringement cases is ordinarily the "clearly erroneous" test mandated by F. R. Civ. P. 52(a).[5] An exception to this rule occurs where the evidence is purely documentary in nature, or where the court actually views the object or device in operation.[6] Kidde here introduced documentary evidence of the state of the prior art and thus contends that this case falls within the above exception. The record clearly shows, however, the introduction of a substantial quantity of oral testimony and physical exhibits in addition to such documents, upon which the District Judge relied, and upon which both parties rely on this appeal. In such circumstances, where findings rest "upon a blending of documentary evidence and oral testimony," the clearly erroneous test is the appropriate standard of review.[7]

On the other hand, the ultimate question of patent validity, including a determination of the obviousness or nonobviousness of the subject matter of a patent, is not subject to the limitations on review under Rule 52(a). Although resting on a factual background, "the question of validity of a patent is a question of law"[8] reviewable free of the clearly erroneous test.

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5. *Jiffy Enterprises, Inc. v. Sears, Roebuck & Co.*, 306 F. 2d 240, 243 (3 Cir. 1962), *cert. den.* 371 U. S. 922 (1962); *R. M. Palmer Company v. Luden's, Inc.*, 236 F. 2d 496, 498 (3 Cir. 1956).

6. *Reese v. Elkhart Welding and Boiler Works, Inc.*, 447 F. 2d 517, 520-21 (7 Cir. 1971); *Deep Welding, Inc. v. Sciaky Bros., Inc.*, 417 F. 2d 1227, 1229-30 (7 Cir. 1969), *cert. den.* 397 U. S. 1037 (1970).

7. *La Salle Street Press, Inc. v. McCormick and Henderson, Inc.*, 445 F. 2d 84, 87 (7 Cir. 1971).

8. *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, 155 (1950); *Philips Electronic and Pharmaceutical Industries Corp. v. Thermal and Electronics Industries, Inc.*, 450 F. 2d 1164, 1174 (3 Cir. 1971).

The District Judge found the patent valid over Kidde's defenses of obviousness, insufficient and indefinite disclosure of the design, addition of new matter, failure to file a supplemental oath, acquisition of intervening rights, double patenting and late claiming.[9] Except for the last two-mentioned objections, Kidde repeats the same contentions here, and urges that if the standard of patentability applied by the District Judge was proper, then that standard is unconstitutional.

Provision for the patentability of designs is found in 35 U. S. C. § 171, which states:

> "Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.
>
> "The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided."

One of these requirements is set out in 35 U. S. C. § 103, which provides:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

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9. Kidde accompanied its answer with a counterclaim for a declaratory judgment of the patent's invalidity on the same grounds submitted as defenses in its answer.

This court has held that a design, to be patentable, must be new, original, ornamental and nonobvious to a worker of ordinary skill in the art to which the design pertains.[10] And, in determining the validity of a design patent, it is the appearance of the article taken as a whole which must meet the statutory requirements since it is "the appearance itself . . . that constitutes . . . the contribution to the public which the law deems worthy of recompense."[11] Beyond this, the law which governs patents does not differ from that generally applicable to other types of inventions.[12]

In Graham v. John Deere Co.,[13] the Supreme Court discussed the method of judicial application under § 103, stating that:

> "Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy."[14]

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10. *Rains v. Cascade Industries, Inc.*, 402 F. 2d 241, 245 (3 Cir. 1968); *R. M. Palmer Company v. Luden's, Inc.*, 236 F. 2d 496, 500 (3 Cir. 1956).

11. *Gorham Company v. White*, 14 Wall. 511, 525 (1871); *Methode Electronics, Inc. v. Elco Corp.*, 385 F. 2d 138, 141 (3 Cir. 1967).

12. *Rains v. Niagara, Inc.*, 406 F. 2d 275, 276 (2 Cir. 1969), *cert. den.* 395 U. S. 909 (1969); *Amerock Corp. v. Aubrey Hardware Mfg., Inc.*, 275 F. 2d 346, 348 (7 Cir. 1960).

13. 383 U. S. 1 (1966).

14. *Id.* at 17-18.

With the addition of § 103 to the Patent Act of 1952, the Congress expressed its intent to shift judicial focus in determining the validity of patents by "emphasiz[ing] 'nonobviousness' as the operative test of the section, rather than the less definite 'invention' language"[15] previously utilized by the courts, which had led to a considerable divergence in decisions.

Under this approach, it is clear that mere distinctions between the design and the prior art are insufficient to warrant a patent. Thus, even where the subject matter of a patent may be different from and unlike the prior art, or "new and pleasing enough to catch the trade," it may not be patentable.[16] Under § 103 it must be determined that the differences between the prior art and the subject matter of the patent are nonobvious to a worker of ordinary skill to justify the issuance of a patent. The courts are bound to a "strict observance" of this rigorous standard.[17]

Where, as in the present case, a combination patent is involved, additional aspects of nonobviousness come into play. The court must "scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements."[18] Such a patent must create a synergistic effect, one in which

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15. *Id.* at 14.

16. *Hygienic Specialties Co. v. H. G. Salsman, Inc.*, 302 F. 2d 614, 618 (2 Cir. 1962); *In Re Lamb*, 286 F. 2d 610, 611 (C. C. P. A. 1961).

17. *Graham v. John Deere Co.*, note 13 *supra*, at 18. This standard, of course, neither diminishes the presumption of validity which attaches to a patent, *Radio Corporation of America v. Radio Engineering Laboratories, Inc.*, 293 U. S. 1 (1934), nor lessens the burden of the party challenging a patent to prove its invalidity. *Eagle Iron Works v. McLanahan Corp.*, 429 F. 2d 1375 (3 Cir. 1970).

18. *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, 152 (1950).

the combination of elements results "in an effect greater than the sum of the several effects taken separately."[19]

After discussing the rules relating to obviousness as set out in § 103 and *John Deere, supra*, the District Judge determined the level of skill of the ordinary worker in the art and the scope of the prior art, specifically scrutinizing in some detail six multisided lighting fixtures which were submitted in evidence by Kidde and were formed from the same components as the patent in suit. He found that:

> "the level of ordinary skill in the art included the ability to design different lighting fixtures of somewhat varying styles having as their component elements a base, a cage, a roof, a vent cap, and a finial. Hexagonal cages of the type employed by Daum were known and commonly employed by other lighting fixture designers a number of years prior to the filing of his application for the patent in suit. Also, roofs corresponding in number of sides to the cage and exhibiting simulated ventilators set out from each panel thereof were a known quantity in lighting fixture design more than a year before the filing of this patent application. It is further true that such roofs were often conical in shape. Moreover, vent caps were commonly superimposed on the roofs of lighting fixtures, paralleling them in some aspects of design. Lastly, the devices of a finial and base were routinely used to complete the design and give it a sense of balance."[20]

The District Judge went on to discuss the differences between the patent in issue and the prior art, but neverthe-

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19. *Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc.*, 396 U. S. 57, 61 (1969); *United States v. Adams*, 383 U. S. 39 (1966).

20. *Hadco Products, Inc. v. Lighting Corporation of America, Inc.*, note 1 *supra*, at 1177.

less found that the Daum lighting fixture displayed many characteristics which set it apart from the prior art. Specifically, he found that:

> ". . . the overall proportions and contour of the Daum patent provide a sharp contrast to both the 'squatty' and 'elongated' designs included in the prior art. (footnote omitted) In addition, the former conveys a subtle sense of simplicity and gracefulness. Such is lacking in the prior art which is characterized, for the most part, by a look of formality and austerity quite foreign to the Daum design. (footnote omitted)
>
> • • • •
>
> "Significant differences of a more specific nature exist between the patent in suit and the prior art. The smooth curve of its finial and vent cap, and especially of its roof, combine to produce in the Daum patent a 'Christmas tree' effect not found in the prior art. (footnote omitted) In addition, the sinusodially curved edges of the Daum roof, integrated with the triangular accents and scallops on the upper surfaces of the eaves, create a visual impression which is substantially different from and unanticipated by any combination of items of the prior art. (footnote omitted)"[21]

The District Judge concluded that these differences "when taken together, make [the Hadco fixture] nonobvious to a person of ordinary skill in the art,"[22] on the reasoning that:

> "Recently the Supreme Court was called upon to interpret the statutory test for nonobviousness in a series of non-design cases. (footnote omitted) Much

21. *Id.* at 1178.

22. 312 F. Supp. at 1177.

of what was said in those cases is difficult to apply in design cases because of the inherent differences between design and non-design patents. (footnote omitted) The requirement of advancement, present in the constitutional standard of patentability, (footnote omitted) seems to have far less practical application in design cases. Moreover, if the Constitution requires that a patent advance or add to the sum of useful knowledge, how can any design patent be constitutional? For, how can a design add to the sum of useful knowledge when a disclosure is merely an artist's view of the device and the patent protection runs only to the ornamental features of the article and not the article itself? (footnote omitted) *On the other hand, if merely a change in design is thought to satisfy the requirement of adding to the sum of useful knowledge, then the only test of patentability in a design case is novelty.* Some writers have suggested as much. (footnote omitted) In addition, the frame of reference with respect to the issue of obviousness in mechanical patent cases is utility, a concept admitting of essentially one definition. This is so because it is defined in terms of the common needs of the members of society. *On the other hand, ornamentation or aesthetic appeal, the frame of reference in design patent cases, is largely a matter of personal taste which varies from individual to individual. Thus, one's feelings and conclusions about a design are to a considerable extent subjective."*[23] (Emphasis supplied).

Thus, while the District Judge noticed the test of obviousness to the worker of ordinary skill in the art, his reasoning and conclusion on the issue were actually based on sub-

23. *Id.* at 1177-78.

jective visual impressions. In this respect apparently he was influenced by the reasoning and test of obviousness enunciated in *In Re Laverne*.[24] In that case, the court found that it could not "implement the legislative intent to promote progress in the field of industrial design by means of the patent incentive"[25] by determining obviousness in terms of the worker of ordinary skill in the art. It substituted a test of obviousness to the ordinary intelligent man, stating that such a test is:

> "inherently a visual test, for the design is nothing more than appearance . . . No special skill is required to determine what things look like, though individuals react differently. It is bound to be an individual reaction."[26]

This test was followed recently by the Ninth Circuit in *Schwinn Bicycle Company v. Goodyear Tire & Rubber Company*.[27] There, on the question of obviousness, the court concluded that " 'the determination of patentability in design cases must finally rest on the subjective conclusion of each judge.' "[28]

These decisions appear to equate obviousness with novelty in the case of design patents. They pose the proposition that unlike a mechanical patent, a design patent should not be tested for obviousness by the yardstick of "a person having ordinary skill in the art," notwithstanding

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24. 356 F. 2d 1003 (C. C. P. A. 1966). The District Judge cited this case, and a law review article discussing its implications. 312 F. Supp. at 1177 n. 5 and 1178 n. 8.

25. 356 F. 2d at 1006.

26. *Id.*

27. 444 F. 2d 295 (9 Cir. 1970).

28. *Id.* at 300, accord, *In Re Facer*, 442 F. 2d 976 (C. C. P. A. 1971); *In Re Schilling*, 421 F. 2d 747 (C. C. P. A. 1970); *but see In Re Durfee*, 412 F. 2d 878 (C. C. P. A. 1969); *In Re Lustig*, 368 F. 2d 1019 (C. C. P. A. 1966).

that specific criterion appears in § 103. They reason that the very nature of the subject matter of design dictates no greater requirement than that the difference between the prior art and the subject matter sought to be patented be obvious to the "ordinary intelligent man" or the "ordinary observer."

The statutory scheme of equating the requirement of nonobviousness of a design patent with that of a mechanical patent renders the decision-making process far from simple, as is highlighted by the philosophical theories enunciated in *Laverne, supra,* and *Schwinn, supra.*[29] And the complexity of current marketing practices may well call for a review of the law governing patents, both mechanical and design, but any basic change in present standards and requirements should be by appropriate legislative reform rather than judicial fiat.

While this court has held that the test of the "ordinary observer" is to be utilized in determining the novelty and ornamentality of a design,[30] it has not departed from the traditional standard of obviousness to a worker of ordinary skill in the art. Thus far, this standard has been deemed appropriate to implement the congressional intent behind § 103, as emphasized in the statement that:

> "the section is added to the statute for uniformity and definiteness. This section should have a stabilizing effect and minimize great departures which have appeared in some cases." [31]

In this light, we are confronted with the question of whether the differences found by the District Judge be-

29. *See* Michaelson, *Design Patents and Obviousness—Obvious to Whom?,* 13 IDEA 495 (1969); Note, *Design Protection—Time to Replace the Design Patent,* 51 MINN. L. REV. 942 (1966).

30. *Rains v. Cascade Industries, Inc.,* 402 F. 2d 241, 247 (3 Cir. 1968).

31. S. REP. No. 1979, 82d Cong., 2d Sess. 6 (1952).

tween the Hadco fixture and the prior art support the conclusion that the design is nonobvious when viewed under the mandate of § 103.

The file wrapper[32] discloses that the Patent Office cited three items of the prior art: two ornamental lighting fixtures, Nos. 1605 and 10576, from the catalog of Meierjohan-Wengler, dated 1953; and design patent No. 77,196 of W. Underwood, dated 1928. These lighting fixtures are six-sided and formed from the same components as the Hadco fixtures, except that the Meierjohan-Wengler lanterns lack vent caps, and Nos. 1650 and 77,196 do not show simulated ventilators. The Underwood lighting fixture projects considerably less formality than the Meierjohan lanterns, which are designed for religious buildings. The cited art is unimpressive in overall appearance for comparison with the Hadco lighting fixture. It is of such limited quantity as to provide little aid on the question of obviousness.

Hadco and Kidde, on the other hand, submitted numerous examples of the prior art in the District Court, none of which were cited by the Patent Office.[33] Of these, the District Judge found it necessary to consider six, Kidde's Items No. 3, 6, 7, 16, 19 and 21(A). A detailed description was devoted to each, which would support a finding of facial distinctions between the Hadco lantern and the prior art, as determined by the District Judge on the basis of his visual impressions.[34] But an ultimate con-

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32. Pl. Ex. 128.

33. Where it is shown that pertinent items of the prior art have not been considered by the Patent Office, the presumption of validity attaching to the patent is weakened. *Chemical Construction Corp. v. Jones & Laughlin Steel Corp.*, 311 F. 2d 367, 371 n. 1 (3 Cir. 1962); *Dole Refrigerating Company v. Amerio Contact Plate Freezers, Inc.*, 265 F. 2d 627, 629 (3 Cir. 1959).

34. 312 F. Supp. at 1176-77.

clusion of nonobviousness required an objective finding that similarity of appearance was so lacking in the prior art as to render the Hadco design as a whole nonobvious to a worker of ordinary skill.

Examining the prior art to this end, it is apparent that substantial similarities to the Hadco fixture's overall contour, appearance, and distinguishing characteristics are present therein. Kidde's Item No. 5, Nos. 469,[35] 470, and 0472, displays lighting fixtures which are quite similar to the Hadco fixtures in overall silhouette and contour.[36] These fixtures are four rather than six sided. Almost identically to the Hadco lantern, however, the roofs, though they appear round rather than hexagonal, curve inwardly as they rise, and flare out horizontally over the cages at their lower edges, terminating in a rippled design. Except for being four sided, the cages also are virtually identical to that of the Hadco fixture in contour of silhouette. While vent caps and simulated ventilators are absent, the lack of these details does not diminish the substantial similarity of these lanterns to the Hadco fixture in overall contour.

The same findings are applicable to Kidde's Item No. 2,[37] which portrays a six-sided lantern affixed outside a residential dwelling. The ribs of the cage ascend upwardly and outwardly toward the roof. It in turn carries out the hexagonal design, curving inward and upward substantially like Hadco's lantern, and is topped with a finial. The lower edge of the roof flares out slightly over the cage and appears to terminate in a scalloped design. As in the case of Nos. 469, 470, and 0472 in Item No. 5, *supra*, this lighting fixture does not have simulated ventilators and

35. This lantern was considered by the District Judge in Item No. 6, which is a photographic enlargement thereof.

36. Herwig Catalog 60, p. 17 (1958) (Def. Ex. 139).

37. Novelty Lighting Catalog 55, p. 17 (1940) (Def. Ex. 142).

a vent cap. In addition, the submitted photograph of the fixture is small, and renders a finely detailed comparison of it with the Hadco lantern difficult. Nevertheless, the basic identity of contour and overall appearance between this lighting fixture and the Hadco is apparent.

An overall similarity to the Hadco lighting fixture in appearance and contour is also found in Kidde's Item No. 13, No. 466.[38] This is also a six-sided lantern. The ribs of the cage ascend outwardly to the roof, which in turn curves inwardly much like the Hadco as it rises to a spike-shaped finial set upon it. It overhangs the cage slightly at its lower edge. This lantern lacks simulated ventilators and a vent cap. The lower edge of its roof does not flare into a scalloped design, but instead terminates in a sheer vertical cut. It is placed upon a thick, inwardly curving hexagonal base which projects a somewhat formal appearance. But, again, these differences do not detract from the similarity of overall contour and silhouette between this lighting fixture and the Hadco lantern.

The representation of similarity in appearance between the Hadco fixture and items of the prior art concededly does not deny the existence of differences. However, while distinctions in detail may sustain a design as novel, they lose significance in establishing nonobviousness, since the primary focus of inquiry in determining design patentability is upon the appearance of the design as a whole.

The stylistic details of the Hadco lighting fixture, which both Hadco and the District Judge emphasized to show nonobviousness in the design, also have parallel examples in the prior art. Items of the prior art, several of which were considered by the District Judge, variously

38. Novelty Lighting Corp. Catalog 49, p. 58 (1935). (Def. Ex. 146).

display cages substantially similar to the Hadco fixture,[39] roofs and vent caps which carry out the same six-sided, inwardly curving pattern as the Hadco lighting fixture,[40] simulated ventilators which follow the contour of the roof,[41] and accented scalloped designs embellishing the vent caps or roofs.[42] None of these features are identically like those of the Hadco lantern. Nevertheless, the components of the Hadco lantern are clearly recognizable as simple modifications.

It is basic that the patentee, as a designer, is chargeable with a comprehensive knowledge of this prior art.[43] And it is implicit in the field of lantern designing that this includes a knowledge of lighting fixtures in terms of their overall appearance, individual components, varying styles, and methods of combination to fit different settings. Kidde's expert witness, Robert Stith, a designer of long experience, testified to the intimate familiarity of the lighting fixture designer with these elements. He stated that scalloped or rippled borders with indented triangular accents were frequently placed on the lower edges of roofs

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39. Item No. 3, No. 1421, Progress Catalog 40, p. 26 (1946) (Def. Ex. 80) considered by the District Judge; Item No. 17, No. 368, Novelty Lighting Corp. Catalog 49, p. 73 (1935) (Def. Ex. 146); Item No. 18, Metrolite Exterior Lighting Equipment Catalog 8, p. 20 (1937) (Def. Ex. 141); Item No. 22, No. 363, Gruber Brothers Three "G" Lighting Catalog 35, p. 25 (1935) (Def. Ex. 143).

40. Item No. 7, photograph of a fixture installed at St. James Lutheran Church, Phila., Pa. (Def. Ex. 177), considered by the District Judge; Item No. 16, photograph of a Hadco lantern sold in 1961 (Def. Ex. 55), considered by the District Judge.

41. Item No. 21(A), photograph from Metalwork Scrapbook (Def. Ex. 184), considered by the District Judge.

42. Items No. 7, 16, note 40, *supra;* Item No. 19 Nos. 066, 067, Gruber Brothers Three "G" Lighting Catalog 35, p. 18 (1935) (Def. Ex. 143).

43. *Continental Can Company v. Crown Cork & Seal Company,* 415 F. 2d 601, 603 (3 Cir. 1969), *cert. den.* 397 U. S. 914 (1970).

and vent caps; that vent caps were commonly designed to follow the contour of the roofs; and that it was common practice for designers to modify or reassemble the basic components of lanterns in various patterns, substituting curved or straight roofs, and adding or deleting simulated ventilators, vent caps and finials to suit customers' tastes.[44] Although much of this testimony was directed to the demands of custom design, the same process—reassembling and restyling well-known components—remains fundamental to the production of "ready made" lighting fixtures produced by the substantial number of present day manufacturers, a prolifically represented in their catalogs in evidence.

Applying this reasoning to the present case, it was to be expected that in producing a new lighting fixture the patentee, as a designer, might retain or delete elements such as a vent cap and simulated ventilators, and vary the artistic details of the components, such as the size and shape of the cage, the contour of the roof and vent cap, and the extent and stylization of scallops and accents on the roof and vent cap. But under § 103 considerably more than such novelty as might result from this exercise of designing skill is required to warrant a patent.

As Hadco contends, and the District Judge found, the Hadco lighting fixture does not duplicate any individual item of the prior art. We readily agree that it is indeed novel and pleasing to the eye. However, as was recently observed regarding a design patent in *Frantz Mfg. Co. v. Phenix Mfg. Co.*:[45]

> "The purpose of the [Patent] statute is to reward, and thereby to encourage, creative artistic activity rather

44. Mr. Stith's testimony begins at vol. 3, p. 913a of the Joint Appendix.

45. Nos. 18975 and 71-1069 (7 Cir., March 16, 1972).

> than mere changes of detail which may produce 'novelty' but do not reflect 'invention.' "

In *R. M. Palmer Co. v. Luden's, Inc.*[46] this court sustained a design patent where the patentee had created fanciful, exaggerated caricatures of hollow chocolate animals in a field that had hitherto seen only realistic animal reproductions in chocolate. The court found that the new designs created a "substantially different aesthetic effect" and "reflect[ed] originality born of inventive faculty."[47] When viewed in light of the prior art, the Hadco lighting fixture, on the contrary, appears simply as an attractive variation on a well-played theme. It does not project the synergistic effect necessary to sustain a patent for a design which is a combination of old and well-known elements. The differences in the Hadco lantern do not create such a new and unexpected result in the appearance of the lighting fixture as a whole as to be a product of invention or of a skill beyond that of the ordinary designer in the art.

Hadco also contends, and the District Judge determined, that the presence of secondary considerations supported the conclusion of nonobviousness. The District Judge found that Hadco's lantern was adaptable to many different indoor and outdoor settings and that Kidde "made no attempt to show that any item of the prior art is or was

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46. 236 F. 2d 496 (3 Cir. 1956).

47. *Id.* at 501. In the recent case of *Trio Process Corp. v. L. Goldstein's Sons, Inc.*, Nos. 71-1295/6 (3 Cir., May 22, 1972), clearly distinguishable from the present case, this court sustained a process patent which consisted of a combination of steps known in the art, reasoning that, "the essence of the *Spits* invention did not lie in the individual steps, but rather, consisted of combining the steps in an unsuggested manner into a process that would achieve a substantially different function and result from the other processes of which the individual stages were a part. (footnote omitted). Where such occurs, the invention of a process may be patentable despite the fact that the individual phases were known in the art."

similarly adaptable."[48] In addition, he considered as an important element the responses Kidde received to inquiries it had addressed to other leaders in the field of lighting fixture manufacture, except for Hadco, as to whether they were producing or knew of a design similar to the Daum patent. The responses were said to be uniformly negative.

Finally, the District Judge emphasized the allegedly outstanding commercial success of the lighting fixture and satisfaction of a long-felt need for such a lantern in the industry as proof of its nonobviousness.[49] This commercial

48. 312 F. Supp. at 1178.

49. On these issues the District Judge found as follows:

"From the time it was placed on the market, the patent in suit gave evidence of satisfying something that was apparently needed in the industry. Surprisingly enough, although the 'Tudor' exhibited a traditional old English appearance, it proved suitable for use in many different geographic and environmental settings. Sales data prepared by the plaintiff (footnote omitted) show that the 'Tudor' became so popular with the purchasing public that in a short time it outstripped all other lighting fixtures made by Hadco. Sales of the 'Tudor' continued upwardly in increasing amounts to and through 1968-1969. In fact, by fiscal year 1967-1968, sales of that fixture adapted for electric lighting accounted for 18% of all catalog electric sales and 13% of the total electric sales of Hadco. The cumulative total of such sales in a six year period amounted to 29,805 units. (footnote omitted).

"Shortly after the Hadco 'Tudor' came on the market, customers of the defendant called upon it to add a similar fixture to its line. With the use of an actual Hadco fixture, the defendant designed and introduced into its line the fixtures alleged to infringe. The amazing similarity in detail between the plaintiff's and defendant's fixtures attests to the substantial impact of the Daum design upon the industry. (footnote omitted).

"Notwithstanding the imitation of plaintiff's design by the defendant and others, and the further fact that the fixtures here alleged to infringe have enjoyed unusual success, (footnote omitted) sales of the Hadco 'Tudor' have continued to rise. This is so even though the accused fixtures are sold at lower prices than are the Hadco fixtures (footnote omitted) and sometimes in the same stores or through the same distributors." 312 F. Supp. at 1179.

success was attributed to the intrinsic merit of the design rather than advertising expenditures, which were found to be quite reasonable.

Under the mandate of *John Deere, supra*, this court has given measured weight to secondary considerations such as commercial success, the opinion of other manufacturers in the pertinent art, and the fulfillment of long-felt need.[50] In determining the validity of a design patent, however, the primary target of inquiry remains the design itself, and the presence of secondary factors " 'without invention will not make patentability.' "[51] Having concluded that the design itself is not a product of invention, it cannot be sustained as nonobvious on the basis of other secondary considerations. "Where . . . invention is plainly lacking, commercial success cannot fill the void."[52]

On this disposition of the case, resolving the underlying issue of patentability against the claims of Hadco, the many other issues raised by Kidde require no further discussion.

The judgment of the District Court filed May 5, 1970 will be vacated and the cause remanded for entry of a judgment denying relief on the complaint of Hadco Products, Inc., and adjudicating its Design Patent No. 199,143 invalid for obviousness under 35 U. S. C. § 103, pursuant to that prayer of the counterclaim of Walter Kidde & Company, appellant.

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50. *Philips Electronic and Pharmaceutical Industries Corp. v. Thermal and Electronic Industries, Inc.*, 450 F. 2d 1164, 1174 (3 Cir. 1971); *Frank W. Egan & Company v. Modern Plastic Machinery Corp.*, 387 F. 2d 319, 324 (3 Cir. 1967), *cert. den.* 361 U. S. 883 (1959).

51. *Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc.*, 396 U. S. 57, 61 (1969); *E. J. Brooks Company v. Stoffel Seals Corp.*, 266 F. 2d 841, 844 (2 Cir. 1959).

52. *Jungersen v. Ostby & Barton Co.*, 355 U. S. 560, 567 (1949).

United States Patent Office

Des. 199,143
Patented Sept. 15, 1964

199,143

LIGHTING FIXTURE

Howard A. Daum, Hanover, Pa.
(P.O. Box 128, Littlestown, Pa.)

Filed Apr. 25, 1963, Ser. No. 74,618

Term of patent 14 years

(Cl. D48—31)

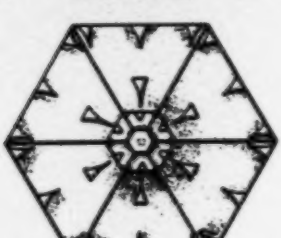

FIG. 2

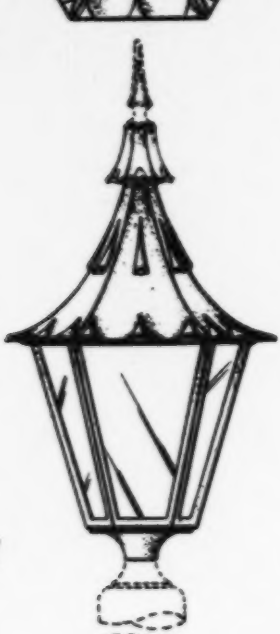

FIG. 1

FIG. 1 is a front elevation of a lighting fixture showing my new design with the standard broken away in part to indicate indeterminate length.

FIG. 2 is a top plan view thereof.

The dominant features of my design reside in the full line portions of the drawings.

The undisclosed rear is the same in appearance as the front shown in FIG. 1.

I claim:

The ornamental design for a lighting fixture, substantially as shown and described.

References Cited by the Examiner

UNITED STATES PATENTS

D-77,196 12/28 Underwood D-48/31

OTHER REFERENCES

Meierjohan Wengler Ornamental Lighting Fixtures and Lanterns Catalog, received Nov. 20, 1953, page 4, top center of page, item No. 1605, lantern.

Meierjohan Wengler Ornamental Lighting Fixtures and Lanterns Catalog, received Nov. 20, 1953, page 5, right center of page, item No. 10576, lantern.

WALLACE R. BURKE, *Acting Primary Examiner.*

UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

No. 19,068

HADCO PRODUCTS, INC.

v.

WALTER KIDDE & COMPANY,
Appellant

(D. C. CIVIL ACTION No. 39056)

ON APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

Present: SEITZ, *Chief Judge* and FORMAN and ALDISERT, *Circuit Judges*

JUDGMENT.

This cause came on to be heard on the record from the United States District Court for the Eastern District of Pennsylvania and was argued by counsel.

On consideration whereof, it is now here ordered and adjudged by this Court that the judgment of the said District Court, entered May 5, 1970, be, and the same is hereby vacated, and the cause remanded for entry of a judgment denying relief on the complaint of Hadco Products, Inc., and adjudicating its Design Patent No.

199,143 invalid for obviousness under 35 U. S. C. § 103, pursuant to that prayer of the counterclaim of Walter Kidde and Company, appellant, all in accordance with the opinion of this Court.

ATTEST:

THOMAS F. QUINN,
Clerk.

June 16, 1972

UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

No. 19,068

HADCO PRODUCTS, INC.

v.

WALTER KIDDE & COMPANY,
Appellant

(D. C. CIVIL ACTION No. 39056)

ON APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

Present: SEITZ, *Chief Judge* and FORMAN and ALDISERT, *Circuit Judges*

AMENDED JUDGMENT.

This cause came on to be heard on the record from the United States District Court for the Eastern District of Pennsylvania and was argued by counsel.

On consideration whereof, it is now here ordered and adjudged by this Court that the judgment of the said District Court, entered May 5, 1970, be, and the same is hereby vacated, and the cause remanded for entry of a judgment denying relief on the complaint of Hadco Products, Inc., and adjudicating its Design Patent No.

199,143 invalid for obviousness under 35 U. S. C. § 103, pursuant to that prayer of the counterclaim of Walter Kidde and Company, appellant, all in accordance with the opinion of this Court. Costs taxed in favor of Appellant.

ATTEST:

M. ELIZABETH FERGUSON,
Chief Deputy Clerk.

July 28, 1972

[1548a]*

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*1548a is the page number of the Appendix in the Court of Appeals.

IN THE

UNITED STATES DISTRICT COURT

FOR THE EASTERN DISTRICT OF PENNSYLVANIA

CIVIL ACTION No. 39056

HADCO PRODUCTS, INC.

v.

LIGHTING CORPORATION OF AMERICA, INC.

OPINION.

BODY, *J.* APRIL 2, 1970

This is an action for the infringement of Design Patent No. 199,143, applied for by Howard A. Daum on April 26, 1963 and issued to him on September 15, 1964.[1] The design involved is directed to a "Tudor" lighting fixture appropriate for both indoor and outdoor use. Plaintiff seeks treble damages under 35 U. S. C. § 284 and an accounting under § 289 of that title. It also seeks injunctive relief and the award of reasonable attorney fees.

The defendant by way of counterclaim seeks a declaratory judgment that the patent is invalid. It asserts as defenses and in support of such a declaration (1) obviousness, (2) insufficient disclosure, (3) indefiniteness, (4) new matter, (5) double patenting, (6) non-infringement, (7) the Muncie Gear doctrine and

1. By virtue of assignments from Mr. Daum dated July 13, 1965 and October 12, 1965, Hadco is the owner of the patent in suit, including all rights of recovery for infringement damages.

[1549a]

(8) plaintiff's failure to file a supplemental oath. The defendant also seeks the award of reasonable attorney fees in the event it is victorious.

The design in question is suggestive of old English architecture and is embodied in a lighting fixture comprising a base, a cage, a roof, a vent cap, and a finial. The base is round in shape, presenting in profile a smooth curve which is relatively sharp at the top and relatively flat at the bottom. The cage forms a regular hexagon with ribs inclining upwardly and outwardly from each corner of the bottom. The roof has an outwardly flared bottom portion with horizontally projecting eaves which overhang the cage and terminate in sinusoidally curved edges. The sides of the roof correspond in number to the sides of the cage, each presenting in profile a smooth curve relatively flat at the top and relatively sharp at the bottom. The upper surfaces of the eaves adjacent to the outer edges thereof are alternately raised and depressed to form a series of triangular accents separated by U-shaped indentations known as scallops. The design also includes a series of six simulated ventilators of triangular configuration, each smoothly curved in profile and set out from the panels of the roof. The roof has superimposed thereon a vent cap with an outwardly flared bottom portion. It too corresponds in number of sides to the cage and has superimposed upon it a pointed finial having six sides and an outwardly flared lower portion.

As usual, plaintiff claims the ornamental design for a lighting fixture "substantially as shown and described."

[1550a]

SUBSTANTIVE DEFENSES.

Obviousness.

Since the defendant does not question the novelty, originality or ornamentality of the patent in suit,[2] we may focus immediately on the issue of obviousness. The Patent Act of 1952 provides for evaluation of the inventive element of a patent as follows:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. . . ." 35 U. S. C. § 103.

In addition, the Supreme Court has directed that our inquiry concerning obviousness take the following form:

> "Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined." *Graham v. John Deere Co.*, 383 U. S. 1, 17 (1966).

The defendant has offered as prior art eleven primary items and fourteen secondary items. We deem it necessary to consider only items #3, 6, 7, 16, 19 and 21(a) in order to define the scope and content of the prior art.

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2. See 35 U. S. C. § 171.

[1551a]

Figure No. 1421 in item #3 appears on page 26 of the 1946 Progress[3] Catalog #40. It is a wall lighting fixture having an hexagonally shaped cage with ribs inclining upwardly and outwardly from the bottom thereof. The ribs themselves are ornamented, and additional ornamental metalwork occupies the horizontal space between the ribs at their upper extremities and extends down over a portion of the intervening vertical panes of glass. This fixture also has a six-sided roof with each panel thereof flaring downwardly and outwardly in a straight line from the top and exhibiting a simulated ventilator set out from its upper surface.

Item #6 is an enlargement of figure No. 469 in item #5. It appears on page 17 of Herwig Catalog #60 and is also a wall lighting fixture. It would seem to have a four-sided cage with ribs at each corner thereof, inclining upwardly and outwardly from the bottom. The fixture is characterized by a round conical roof which flares downwardly and outwardly from the top, presenting a flat and somewhat uneven curve in profile. The lower portion of the roof overhangs the cage and terminates in a wavily curved edge.

Item #7 is a photograph of a lighting fixture affixed to the St. James Lutheran Church in Philadelphia. This fixture exhibits a straight, vertical omni-sided cage with ribs at its corners and an additional such rib located between the corner ribs for each

[1552a]

side. Some of the intermediate ribs extend up through the

3. Progress Manufacturing Company, Inc. was a Pennsylvania corporation which existed until April 25, 1966. On that date a certificate of amendment was issued changing the name of that corporation to Lighting Corporation of America, the defendant herein.

lower portion of the overhanging roof and terminate in fleur-de-lis ornaments. Further ornamentation of the intermediate ribs is achieved by varying their predominantly rectangular configuration with a twisted middle section. A thin twisted length of metal horizontally encircles the cage at its upper and lower ends. A cone-shaped roof, corresponding in number of sides to the cage, flares downwardly and outwardly, its lower portion overhanging the cage and terminating in decoratively patterned edges. Horizontally encircling the cage below the overhanging portion of the roof is a vertically depending, ornamented metal skirt, while set out from at least one side of the roof is a simulated ventilator. Superimposed upon and overhanging the upper portion of the roof is a vent cap corresponding in miniature to the design of the roof, except for the absence of simulated ventilators. An ornate fleur-de-lis finial styled in the motif of the intermediate ribs is in turn mounted upon the vent cap.

Item #16 incorporates two views of a lighting fixture sold by the plaintiff in 1961. It too has an elongated, omnisided cage with straight vertical ribs at each corner. As with the lighting fixture affixed to St. James Lutheran Church, it has a roof which corresponds in number of sides to the cage and declines downwardly and outwardly in a straight line until reaching the top of the cage and terminating in slightly scalloped edges. This Hadco fixture has a vent cap superimposed upon and corresponding in miniature to the design of the roof.

[1553a]

Item #19, and more specifically figures 066 and 067 therein, show variations of a lighting fixture having a multisided conical roof. Each side descends downwardly and outwardly in a straight line, terminating in sinusodially

curved edges. Alternate sides exhibit simulated ventilators set out from their respective planes.

Finally, item #21(a) constitutes an enlargement of a photograph taken from a metalwork scrapbook. It shows a lighting fixture having a small multi-sided roof which exhibits a gradual bell-shaped curve downward and outward from its top. Set out from each panel of the roof is a simulated ventilator, purporting to follow ever so slightly the curve of the roof.

Summarizing, then, the level of ordinary skill in the art included the ability to design different lighting fixtures of somewhat varying styles having as their component elements a base, a cage, a roof, a vent cap, and a finial. Hexagonal cages of the type employed by Daum were known and commonly employed by other lighting fixture designers a number of years prior to the filing of his application for the patent in suit. Also, roofs corresponding in number of sides to the cage and exhibiting simulated ventilators set out from each panel thereof were a known quantity in lighting fixture design more than a year before the filing of this patent application. It is further true that such roofs were often conical in shape. Moreover, vent caps were commonly superimposed on the roofs of lighting fixtures, paralleling them in some aspects of design. Lastly, the devices of a finial and base were routinely used to complete the design and give it a sense of balance.

[1554a]

In contrast, however, there are many characteristics of the patent in suit which set it apart from the prior art and which, when taken together, make it nonobvious to a person of ordinary skill in the art.

Recently the Supreme Court was called upon to interpret the statutory test for nonobviousness in a series of

non-design cases.[4] Much of what was said in those cases is difficult to apply in design cases because of the inherent differences between design and non-design patents.[5] The requirement of advancement, present in the constitutional standard of patentability,[6] seems to have far less practical application in design cases. Moreover, if the Constitution requires that a patent advance or add to the sum of useful knowledge, how can any design patent be constitutional? For, how can a design add to the sum of useful knowledge when a disclosure is merely an artist's view of the device and the patent protection runs only to the ornamental features of the article and

[1555a]

not the article itself?[7] On the other hand, if merely a change in design is thought to satisfy the requirement of adding to the sum of useful knowledge, then the only test of patentability in a design case is novelty. Some writers have suggested as much.[8] In addition, the frame of ref-

4. *Graham v. John Deere Co.*, supra; *United States v. Adams*, 383 U. S. 39 (1966); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc.*, 38 U. S. L. W. 4024 (U. S. December 8, 1969).

5. See *In Re Laverne*, 356 F. 2d 1003 (C. C. P. A. 1966) and *In Re Faustmann*, 155 F. 2d 388 (C. C. P. A. 1946).

6. See *Graham v. John Deere Co.*, supra, where the Supreme Court said: "This qualified authority, (granted by Art. I, § 8, cl. 8), unlike the power often exercised in the sixteenth centuries by the English Crown, is limited to the promotion of *advances* in the 'useful arts.'" (emphasis added).

"Nor may (Congress) . . . enlarge the patent monopoly without regard to the innovation, *advancement* or social benefit gained thereby." (emphasis added).

"Innovation, *advancement*, and *things which add to the sum of useful knowledge* are inherent requisities in a patent system which by constitutional command must 'promote the Progress of . . . useful Arts.'" (emphasis added).

7. See Note, *The 1966 Patent Cases: Creation of a Constitutional Standard*, 54 Geo. L. J. 1320 (1966).

8. Note, *Design Protection—Time to Replace the Design Patent*, 51 Minn. L. R. 942 (1967); *In Re Laverne, supra.*

erence with respect to the issue of obviousness in mechanical patent cases is utility, a concept admitting of essentially one definition. This is so because it is defined in terms of the common needs of the members of society. On the other hand, ornamentation or aesthetic appeal, the frame of reference in design patent cases, is largely a matter of personal taste which varies from individual to individual. Thus, one's feelings and conclusions about a design are to a considerable extent subjective.

Along this line, the overall proportions and contour of the Daum patent provide a sharp contrast to both the "squatty" and "elongated" designs included in the prior art.[9] In addition, the former conveys a subtle sense of simplicity and gracefulness. Such is lacking in the prior art which is characterized, for the most part, by a look of formality and austerity quite foreign to the Daum design.[10] Moreover, the appearance of grace and simplicity is heightened by the fact that the simulated ventilators in the Daum patent follow the curve of the roof in profile.

[1556a]

Another way in which the patent in suit differs markedly from the prior art is in its adaptability to different geographical and environmental settings. It has found use, for example, both indoors and outdoors in ranch houses, motels, hotels, restaurants, ski lodges, shopping centers, youth centers, churches and fraternity houses, as well as numerous types of commercial and privately owned residential structures, including houses of both colonial and contemporary architecture. It has been applied to posts in front of houses, to walls and over doorways by means of supporting brackets and pendant chains, and to ceiling fix-

9. Df. Ex. #210, items 4-7, 10-16, 21, 21(a).
10. See Df. #210, items 3, 4, 7-19, 21-22.

tures of a large variety, including circular bands and the like.[11] The defendant, on the other hand, made no attempt to show that any item of the prior art is or was similarly adaptable. On the contrary, it indicated through its witnesses that such designs were custom-created. This difference between the Daum patent and the prior art constitutes the type of advancement or promotion of the useful arts which the Supreme Court found implicit in the constitutional standard of patentability.

Significant differences of a more specific nature exist between the patent in suit and the prior art. The smooth curve of it finial and vent cap, and especially of its roof, combine to produce in the Daum patent a "Christmas tree" effect not found in the prior art.[12] In addition, the sinusodially curved edges of the Daum roof, integrated with the triangular accents and scallops on the upper surfaces of the eaves, create a visual impression which is substantially different from and unanticipated by any combination of items of the prior art.[13]

[1557a]

The nonobviousness of the Daum patent over the prior art is indicated in still another way. Using the directory of "Lighting" magazine as a guide, the defendant began writing to the leading manufacturers of lighting fixtures with the exception of Hadco.[14] It sent them a copy of the Daum patent and inquired as to whether they knew of the sale or advertising of a similar fixture. As may be seen

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11. See Pf. Ex. #121(a)-121(o).

12. Item 7 of Df. Ex. #210, the St. James fixture, does not present such an appearance because of the shape of its finial, the presence of the fleur-de-lis ornaments extending up through its roof and the length of its cage in relation to the size of its roof and vent cap. (See Pf. Ex. #128, pp. 42-44).

13. See Df. Ex. #210, items 5-7, 16, 19.

14. Pf. Ex. #26(a)-26(y).

from the replies,[15] the addressees produced nothing in the way of anticipatory prior art, and many stated that they knew of no such fixture prior to the Daum patent. Indeed, one of the manufacturers wrote to the plaintiff as well as the defendant, commenting upon the latter's reputation as a copier of the designs of others.[16]

The Supreme Court recently pointed out that at least insofar as mechanical patents are concerned, such considerations as commercial success and long felt but unsolved need may have relevancy to the issue of nonobviousness but are only secondarily important as individual criteria.[17] However, since one's evaluation of a design is in some measure the product of subjectivity, it may be that these considerations take on added weight as indicia of nonobviousness when design patents are involved.[18] In any event, we hold that the facts previously recited established that the patent in suit teaches something of significance not previously disclosed.[19] Upon that basis we conclude that the following facts, insofar as they relate to such factors as commercial success and long felt need, are relevant to and supportive of our determination of nonobviousness.[20]

[1558a]

From the time it was placed on the market, the patent in suit gave evidence of satisfying something that was apparently needed in the industry. Surprisingly enough, although the "Tudor" exhibited a traditional old English

15. Pf. Ex. #27(a)-27(h).

16. Pf. Ex. #148; see also N. T. 268-279.

17. *Graham v. John Deere Co.*, supra, at 17-18.

18. Cf. Boyer, *Commercial Success as Evidence of Patentability*, 37 Ford. L. R. 573 (1969).

19. *Continental Can Company v. Crown Cork & Seal Company*, 415 F. 2d 601 (3d Cir. 1969).

20. *United States v. Adams*, supra, note 6; *Jones Knitting Corporation v. Morgan*, 361 F. 2d 451 (3d Cir. 1966).

appearance, it proved suitable for use in many different geographic and environmental settings. Sales data prepared by the plaintiff[21] show that the "Tudor" became so popular with the purchasing public that in a short time it out-stripped all other lighting fixtures made by Hadco. Sales of the "Tudor" continued upwardly in increasing amounts to and through 1968-1969. In fact, by fiscal year 1967-1968, sales of that fixture adapted for electric lighting accounted for 18% of all catalog electric sales and 13% of the total electric sales of Hadco. The cumulative total of such sales in a six year period amounted to 29,805 units.[22]

Shortly after the Hadco "Tudor" came on the market, customers of the defendant called upon it to add a similar fixture to its line. With the use of an actual Hadco fixture, the defendant designed and introduced into its line the fixtures alleged to infringe. The amazing similarity in detail between the plaintiff's and defendant's fixtures attests to the substantial impact of the Daum design upon the industry.[23]

[1559a]

Notwithstanding the imitation of plaintiff's design by the defendant and others, and the further fact that the fixtures here alleged to infringe have enjoyed unusual success,[24] sales of the Hadco "Tudor" have continued to rise. This is so even though the accused fixtures are sold at lower prices than are the Hadco fixtures[25] and sometimes in the same stores or through the same distributors.

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21. Pf. Ex. #126(a)-126(f).

22. N. T. 655-665.

23. As further evidence of this industry-wide impact, see Pf. Ex. #123-124 pertaining to *Hadco Aluminum Products Co. v. Frank Dini Co.*, Civil No. 1112-65 (D. N. J.) wherein a consent judgment was entered in plaintiff's favor in 1966.

24. Pf. Ex. #140.

25. See Pf. Ex. #127(a)-127(d).

From time to time courts have discounted the importance of such considerations as commercial success in connection with the inventive element of a patent. More often than not this is because they have suspected that factors other than the worth or merit of the patent produced them.[26] Such is not the situation with the patent in suit. There is no evidence that the commercial success enjoyed by the Hadco "Tudor" was due to anything other than the inherent appeal of the design there embodied. This conclusion is amply supported by the fact that Hadco spent comparatively small sums in advertising the same. The total amount of money spent in promoting the "Tudor", including monies spent for advertising, printing of brochures and catalogs, trade shows, newspaper advertisements and the like during the years 1962 through 1966 was $12,234.00.[27]

One final question concerning nonobviousness must be considered. The defendant asserts that the standards in this area are stricter for combination patents, such as the one in suit. It further contends that these standards have not been met here. In support of its first contention it cites language to the effect that

[1560a]

> ". . . the standards are, if anything, stricter for combinations of design elements." *Rains v. Niaqua*, 406 F. 2d 275, 279 (2d Cir. 1969).

It should be noted in passing that the *Rains* court did not specifically hold that stricter standards exist for combination patents. The above language was merely responsive to the admonition of the Supreme Court that reviewing bodies "scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements." *A & P Tea Co. v.*

26. See *McClain v. Ortmayer*, 141 U. S. 486 (1876).
27. Df. Interrog. #31 and Pf. Answer thereto.

Supermarket Corp., 340 U. S. 147, 152 (1950). This Court has heeded that admonition and considers its holding of nonobviousness consistent therewith.[28]

TECHNICAL DEFENSES.

Indefiniteness and Insufficient Disclosure.

The defendant makes a three-pronged attack upon the definiteness of the patent drawings in suit and the sufficiency of their disclosure. It contends that the Hadco patent is invalid because 35 U. S. C. § 112, Patent Office Rule 152, and § 1503.02 of the Manual of Patent Examining Procedure have been violated.[29]

[1561a]

An initial question arises as to the force and effect of the Patent Office Rules and the Manual of Patent Examing

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28. We also consider our holding to be consistent with the principles enunciated in *Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc.*, supra, note 6, the latest pronouncement by the Supreme Court in the area of combination patents.

29. 35 U. S. C. § 112 provides in pertinent part: "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention."

Patent Office Rule 152 states: "The design must be represented by a drawing made in conformity with the rules laid down for drawings of mechnical inventions and must contain a sufficient number of views to constitute a complete disclosure of the appearance of the article. Appropriate surface shading must be used to show the character or contour of the surfaces represented."

Section 1503.02 of the Manual of Patent Examining Procedure reads in part: "The necessity for good drawings in a design application cannot be overemphasized. As the drawing constitutes substantially the whole disclosure of the design, it is of utmost importance that it be so well executed both as to clarity of showing and completeness that nothing regarding the shape, configuration and surface ornamentation of the article sought to be patented is left to conjecture."

Procedure. The former have been held to have the force and effect of law to the extent they are not inconsistent with the express provisions of the Patent Statute.[30] The latter, on the other hand, has been characterized as follows:

> "This manual is not provided for expressly in the statutes, but is primarily a set of instructions to the examining corps of the Patent Office from the Commissioner acting in his supervisory capacity." *In Re Kaghan*, 387 F. 2d 398, 401 (C. C. P. A. 1967).

It is thus apparent that the Manual can rise no higher in status than the Patent Office Rules. The question of its exact force and effect need not be answered, however, since for present purposes we will accord both provisions equal status.

It seems apparent from their content that both Rule 152 and Section 1503.02 of the Manual were intended as extensions of the requirement found in Section 112 of the Patent Act. By implication, therefore, they employ the same frame of reference as that found in Section 112—namely, a person skilled in the pertinent art. Consequently, we hold that Rule 152, as construed, is a valid and effective regulatory provision under 35 U. S. C. § 6. For the purpose of this inquiry we will assume the same concerning Section 1503.02 of the Manual.

[1562a]

We turn now to the question of definiteness and sufficiency of disclosure. It has been held in connection therewith that:

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30. *In Re Rubinfield*, 270 F. 2d 391 (C. C. P. A. 1959); *Sperry Rand Corp. v. Bell Telephone Laboratories, Inc.*, 171 F. Supp. 343 (S. D. N. Y. 1959); *Gearon v. United States*, 121 F. Supp. 652 (Ct. Cl. 1954)

"'. . . plaintiff must stand on his patent as issued; its meaning, intended significance, and asserted scope must be primarily learned from the four corners of the document as it stands . . .' *Whiting Mfg. Co. v. Alvin Silver Co.*, 283 F. 75, 80 (2 Cir. 1922)." *Philco Corp. v. Admiral Corp.*, 199 F. Supp. 797, 801 (D. Del. 1961).

The defendant points out numerous mechanical errors and various inconsistencies between figures #1 and #2 of the drawings as issued. Upon that basis it asserts that the design is indefinite and insufficiently disclosed. The Court has carefully reviewed the evidence and has studied each alleged defect cited to it. It thereupon concludes that the errors and inconsistencies in the drawings as issued are inconsequential and do not, either singularly or in toto, constitute a violation of either the statutory or regulatory provisions. Bearing in mind that definiteness and sufficiency of disclosure are to be determined with respect to a person skilled in the art, it must be observed that the defendant offered no expert testimony in this area. Mr. Stith, its lighting fixture designer, was not questioned on the subject, and Mr. Fiddler, a patent attorney and former examiner in the Patent Office, was not a person skilled in the art of designing lighting fixtures.[31] The plaintiff, on the other hand, produced Mr. Yellin, an architect and an experienced designer of about five hundred lighting fixtures.[32] Upon direct examination he testified that the er-

31. Mr. Fiddler stated that he had not worked in the Design Division of the Patent Office (N. T. 1779-1780). Although he did testify to having filed several hundred design patent applications (N. T. 1646-1647), this does not result in his bringing to the evaluation of a design the creative and aesthetic sense of an ordinary designer of lighting fixture.

32. N. T. 528-531, 548.

rors and inconsistencies cited by the defendant would present no

[1563a]

problem as far as duplication and use of the design in suit are concerned.[33] Moreover, his testimony withstood vigorous cross-examination during which he consistently maintained the view that the drawings enable even an average designer of lighting fixtures to make and use the design in suit without conjecture.[34] That testimony is strong evidence of compliance with the statutory and regulatory provisions and it adequately supports out holding of no violation.

New Matter and Supplemental Oath.

The next asserted ground of invalidity is that the scope of the patent was broadened by the insertion of amendatory new matter in the original application, unaccompanied by a supplemental oath.[35]

In analyzing this contention it is important to bear in mind that considerable weight must be given to the patent examiner's decision on this point. Courts have stated that the action of the Patent Office in permitting an amendmant constitutes an implicit determination that no new matter is included therein. Such a determination, it is said, is entitled to special weight and should not be disturbed unless clearly erroneous. *Baldwin-Lima-Hamilton Corp. v. Talsall*, 169 F. Supp. 1 (E. D. Pa. 1958), aff'd 268 F. 2d 395 (3d Cir. 1959), cert. denied 361 U. S. 894 (1959); *Technicon Instruments Corp. v. Coleman Instruments Corp.*, 385 F. 2d 391 (7th Cir. 1967); *Aerosol Research Co. v. Scovill Mfg.*

33. N. T. 626-627.
34. N. T. 635-640.
35. See 35 U. S. C. § 132; Patent Office Rules 118 and 67(a).

Co., 334 F. 2d 751 (7th Cir. 1964); *Helms Products v. Lake Shore Mfg. Co.*, 227 F. 2d 677 (7th Cir. 1955). It must be noted that the reason underlying this rule is clear and quite different from that giving rise to the general statutory presumption of a

[1564a]

patent's validity.[36] Concerning the latter it has been noted that the considerations taken into account by the Patent Office, and the vantage point from which it approaches the issue of validity, are often different from those of a court in an infringement suit. For this reason, the force of the general statutory presumption of validity is weakened considerably. *Blumcraft of Pittsburgh v. Citizens & Southern Nat. Bank*, 407 F. 2d 557 (4th Cir. 1969), cert. denied 395 U. S. 961 (1969); *Howe v. General Motors Corp.*, 401 F. 2d 73 (7th Cir. 1968), cert. denied 394 U. S. 919 (1969); *Schmidinger v. Welsh*, 383 F. 2d 455 (3d Cir. 1967). On the other hand, the approach to the issue of new matter is the same for both the patent examiner and the court. Thus increased weight is accorded the former's determination in this regard.

Moreover, it is clear that the patent examiner in the case at bar was keenly aware of the question of new matter and made a definite determination that none was included in the amendments he accepted.[37]

That brings us to the question of whether or not the action of the Patent Office was clearly erroneous. We believe it was not. It is undisputed that several changes were made to the drawings as filed during the course of prosecution.[38] The defendant contends, however, that these changes

36. 35 U. S. C. § 282.
37. See Df. Ex. #40, pp. 5, 14, 18.
38. Df. Ex. #40.

resulted in such a drastic alteration of the original design that a completely new one was created. With this the Court cannot agree. Section 132 and Rule 118 prohibit the amend-

[1565a]

ment of the original application in such a way as to broaden the scope of the patent. *Reeves Bros., Inc. v. U. S. Laminating Corp.*, 282 F. Supp. 118, 130 (E. D. N. Y. 1968). On the other hand, drawings and specifications may be amended to conform to one another. *In re Heinle*, 342 F. 2d 1001 (C. C. P. A. 1965). They may also be amended for purposes of clarity and definiteness, *Technicon Instruments Corp. v. Coleman Instruments Corp.*, supra; *Helms Products v. Lake Shore Mfg. Co.*, supra; *Reeves Bros., Inc. v. U. S. Laminating Corp.*, supra, or to add a claim concerning something which is fairly deducible from the original application. *Hobbs v. Beach*, 180 U. S. 383 (1901); *Preformed Line Products Co. v. Fanner Manufacturing Co.*, 225 F. Supp. 762 (N. D. Ohio 1962), aff'd 328 F. 2d 265 (7th Cir. 1964), cert. denied 379 U. S. 846 (1964); *Drumhead Company of America v. Hammond*, 18 F. Supp. 734 (W. D. Pa. 1936), aff'd 89 F. 2d 241 (3d Cir. 1937).

In the present case it seems clear that all the amendments were made for the sole purpose of achieving clarity and internal consistency. Moreover, without exception they were made during the initial prosecution of the patent [39] and at the request of the patent examiner who closely scrutinized them with regard to new matter. Under these circumstances we find that the latter's determination was not clearly erroneous and we therefore adopt it.

Further, it was unnecessary for the applicant to file a supplemental oath since no new matter was added and

39. See *Hestonville, M. & F. Pass. Ry. Co. v. McDuffee*, 185 F. 798, 802 (3d Cir. 1910).

no amendment was made to the original claim. *Aerosol Research Co. v. Scovill Mfg. Co.*, supra.

[1566a]

Double Patenting.

Defendant's next attack upon the validity of the patent in suit is based on the assertion that it violates the rule against double patenting. While there are many reasons for applying this rule,[40] the primary one here advanced by the defendant concerns the avoidance of a multiplicity of patents for a single invention.

Defendant argues that Design Patents Nos. 199,142 and 199,143, both of which issued to Howard A. Daum on September 15, 1964, involve the same creative design. Since it is well settled that only one patent may issue for a single invention, *Miller v. Eagle Mfg. Co.*, 151 U. S. 186 (1894); *Underwood v. Gerber*, 149 U. S. 224 (1893); *In re Siu*, 222 F. 2d 267 (C. C. P. A. 1955), defendant reasons that the patent in suit (No. 199,143) is necessarily invalid. The fallacy in this argument is that the two patents are not directed to the same design. The "Tudor" design (No. 199,143) was conceived prior to the "Camelot" design (No. 199,142). It is much taller in relation to its width and presents to the eye a radically different outline than does the "Camelot". In addition, the "Tudor" has straight ribs and an hexagonal roof, whereas the corresponding elements of the "Camelot" are curved and conical respectively. The ornamentation at the roof edges is entirely different in the two designs, as are the number and position of the simulated ventilators. The vent caps and finials in the two designs are also different in configuration. In the "Camelot" design there is a cylindrical

40. See *In Re Robeson*, 331 F. 2d 610, 615 (C. C. P. A. 1964).

roof section beneath the vent cap which has no counterpart in the "Tudor". Finally, sales figures clearly show public opinion to be that the "Tudor" and "Camelot" involve separate and distinct designs.[41]

[1567a]

In a related argument the defendant asserts that even if the patents are not directed to the same design, the "Tudor" design is not patentably distinct from the "Camelot", and it therefore violates the rule against double patenting. It is true that the prohibition against multiple patents for a single invention has been extended to apply to designs which are merely colorable variations of one another. *In re Robeson*, 331 F. 2d 610, 615 (C. C. P. A. 1964). However, the same facts which demonstrate that the patents in question are not directed to the same design, foreclose the contention that they are mere colorable variations of one another. Moreover, patents which display a greater degree of dissimilarity do not fall within the purview of this branch of the rule against double patenting.

Defendant's related argument is relevant, however, to that branch of the rule which is based upon the objection to the extension of the monopoly. Patents directed to distinctly different but obvious designs violate the rule against double patenting unless they expire on the same day. *In re Robeson*, supra. On the other hand, patents involving designs which are patentably distinct do not violate the rule, regardless of their expiration date. *Continental Can Company v. Crown Cork & Seal Co.*, 281 F. Supp. 474, 480 (E. D. Pa. 1967), *rev'd on other grounds*,

41. The "Tudor" has accounted for a substantial percentage of Hadco's total sales. Sales of the "Camelot", on the other hand, have been practically insignificant, amounting to less than 1% of the "Tudor" sales (N. T. 693-694, 770-771).

415 F. 2d 601 (3d Cir. 1969). In the instant case the patents terminate on the same day. Consequently we need not inquire whether the designs involved are patentably distinct, for in any event defendant's argument cannot prevail.

Liberally construing defendant's contentions, we find them to include the additional argument that Mr. Daum's activities in connection with the filing of the patent applications here in ques-

[1568a]

tion were carried out with the intent to mislead the Patent Office or to conceal information from it. Suffice it to say that the evidence does not support such an interpretation of his actions, and we will refuse to sustain the defense of double patenting on that basis.

Muncie Gear Doctrine.

Howard Daum filed his application for the patent in suit on April 25, 1963, less than a year after the first "Tudor" lantern was sold on June 26, 1962. He subsequently amended his application for the first time on March 10, 1964. The defendant asserts that the collective effect of all the amendments made to Daum's application was to alter both its specification and claim, thereby rendering the design ineligible for patent protection.

Section 102 of Title 35, U. S. C., provides in part:

"a person shall be entitled to a patent unless—

(b) the invention was . . . in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States. . . ."

The application date referred to in the statute is normally the date on which the original application was filed. Under the Muncie Gear doctrine,[42] however, applications are sometimes viewed with respect to late or altered claims as if filed when the claims are presented to the Patent Office. Such a view subjects them to any statutory bar then applicable.

[1569a]

The Muncie Gear doctrine is not applicable to this case because of our finding that the claim was never changed and only minor alterations were made in the drawings for the purpose of consistency and clarity.

Non-infringement.

Plaintiff asserts that fixtures P-5407,[43] P-5507,[44] P-5417,[45] P-5608[46] and P-5607[47] of the defendant infringe the patent in suit. The defendant has admitted manufacture and sale of these fixtures but denies infringement.

The latter correctly argues that the accused fixtures must be compared for purposes of infringement with the patent as issued and not with plaintiff's fixtures manufactured thereunder. *Aileen Mills Co. v. Ojay Mills, Inc.*, 188 F. Supp. 138 (S. D. N. Y. 1960). In view of our prior findings, however, we cannot accept the defendant's further argument that figures 1 and 2 of the drawings as issued are irreconcilable and therefore render the patent insusceptible of infringement.

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42. *Muncie Gear Works v. Outboard Marine and Manufacturing Co.*, 315 U. S. 759 (1942).
43. Pf. Ex. #24.
44. Pf. Ex. #53, p. 71.
45. Pf. Ex. #48.
46. Df. Ex. #150.
47. Df. Ex. #243.

The defendant also takes issue with plaintiff's charge of infringement on the merits. The test applicable in design cases was long ago set forth in *Gorham Company v. White*, 81 U. S. 511 (1872), where the Supreme Court said:

> "We hold, therefore, that if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other." 81 U. S. at 528.

[1570a]

By way of amplification it should be noted that design patents, like mechanical patents, are entitled to a range of equivalents. *Gorham Company v. White*, supra; *Sanson Hosiery Mills, Inc. et al. v. Warren Knitting Mills, Inc.*, 202 F. 2d 395 (3d Cir. 1953). Further, infringement is complete if the defendant's design imparts to the mind the same general idea of ornamentation and appearance as is found in the patentee's design. Mere difference of lines in the drawing or sketch, a greater or smaller number of lines, or slight variances in configuration, if sufficient to change the effect upon the eye, will not destroy the substantial identity.[48] Finally, general appearance, rather than minute detail, constitutes the substance of a design patent, and its imitation the infringement. *Harris & Schafer, Inc. v. Curtiss Aerocar Co., Inc.*, 69 F. 2d 264 (5th Cir. 1934).

Defendant's fixtures P-5407, P-5507 and P-5417 have the same general appearance as the patent in suit. Such differences as exist between the individual accused fixtures and the Hadco patent amount to fine distinctions not nor-

48. *Gorham Company v. White*, supra, at 526-527.

mally detectable by the eye of an ordinary observer. Even when closely scrutinized these differences are minute and inconsequential. We therefor hold these fixtures to infringe the patent in suit.

Fixtures P-5608 and P-5607 require individual analysis. Fixture P-5607 is a mere colorable variant of the P-5407 style. In lieu of a vent cap, its finial is so proportioned and flared as to produce substantially the same visual effect as the patent in suit.

[1571a]

In overall appearance there is such close similarity that an ordinary observer could readily confuse the two. Fixture P-5608 creates an overall appearance which is similar to that of both P-5607 and the patent in suit. The only difference between fixtures P-5608 and P-5607 is that the former has no base. This is occasioned solely by the manner in which the former is wall-mounted and is therefore of minimal significance with respect to the embodied design. Like P-5607, fixture P-5608 exhibits the dominant motif of the Daum design, thus creating an overall aesthetic effect of identity. For these reasons we hold that fixtures P-5607 and P-5608 also infringe the patent in suit.

Attorneys' Fees.

The award of attorneys' fees is reserved for exceptional cases. 35 U. S. C. § 285. A request for such an award is also addressed to the sound discretion of the court. One court has articulated the standard to be applied as follows:

> "The standard to be applied in determining whether attorney fees should be awarded to the prevailing party is whether there is a showing of unfairness or bad faith in the conduct of the losing party, or any

other equitable consideration of similar force which makes it grossly unfair that the winner of the lawsuit be left to bear the burden of his own counsel fees." *Crown Machine & Tool Co. v. KVP-Sutherland Paper Co.*, 297 F. Supp. 542, 577 (N. D. Cal. 1968), aff'd 409 F. 2d 1307 (9th Cir. 1969).

It is the opinion of this Court that plaintiff has not sustained its burden[49] of showing such unfairness or inequity on the part of the defendant as to warrant the awarding of attorneys'

[1572a]

fees. The latter was advised by counsel that the patent was invalid and not infringed. It acted in reasonable reliance on that advice and thereafter proceeded to litigate this action in good faith. Such conduct does not rise to the level necessary for the granting of plaintiff's request. *Continental Can Co. v. Anchor Hocking Glass Corp.*, 362 F. 2d 123 (7th Cir. 1966); *Park-in-Theatres v. Perkins*, 190 F. 2d 137 (9th Cir. 1950).

RALPH C. BODY, *J.*

[1573a]

Sent by
JOHN J. HARDING
Clerk, United States District Court
Eastern District of Pennsylvania
at Philadelphia 19107

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49. *Arimoore Co. v. Dayless Mfg. Co.*, 208 F. 2d 1 (7th Cir. 1953), cert. denied 347 U. S. 920 (1954).

IN THE
UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA.

CIVIL ACTION No. 39,056.
PROTRACTED CASE.
JUDGE BODY.

HADCO PRODUCTS, INC.,
Plaintiff,

v.

WALTER KIDDE & COMPANY, INC.,
SUBSTITUTED DEFENDANT FOR
LIGHTING CORPORATION OF AMERICA, INC.,
Defendant.

JUDGMENT.

(Judgment entered 5-5-70)

This action came on for trial before the Court, Honorable Ralph C. Body, United States District Judge, presiding, and the issues having been duly tried and a decision having been duly rendered,

It Is Ordered, Adjudged and Decreed That:

1. United States Letters Patent Des. No. 199,143, entitled "Lighting Fixture" is in all respects valid.

2. Plaintiff is the assignee and owner of said patent, including all rights of recovery for infringement thereof.

3. The defendant has infringed said patent by making, using and selling defendant's lighting fixtures P-5407, P-5417, P-5507, P-5607 and P-5608.

4. The defendant, including its officers, agents, servants, employees and attorneys and those persons controlled

[1574a]

by defendant or in active concert or participation with it, and each of them, are enjoined from:

(a) making, using or selling defendant's fixtures P-5407, P-5417, P-5507, P-5607, and P-5608;

(b) making, using or selling any lighting fixture embodying the invention covered by United States Letters Patent Des. No. 199,143, or otherwise infringing or contributing to the infringement of said patent during the life thereof.

5. Subject to the limitations of 35 U. S. C. § 287, the plaintiff is entitled to an accounting to ascertain the damages and profits due it as the result of said infringement, and judgment for such monetary award so ascertained, the matter of increasing said damages being deferred until further order of the Court.

6. Defendant's counterclaim for declaratory judgment is dismissed with prejudice.

7. Plaintiff shall recover its costs but is not entitled to an award of attorneys' fees.

8. This Judgment shall be binding upon Walter Kidde & Company, Inc., a corporation of Delaware, as successor to and assignee of Lighting Corporation of America, Inc.

9. The injunction of paragraph Four (4) of this Judgment and the accounting of paragraph Five (5) of this Judgment are to be stayed pending the determination of the appeal from this Judgment provided that within ten (10) days from the date of entry of this Judgment defend-

ant posts a bond in the amount of Fifteen Thousand Dollars ($15,000.00) and files a Notice of Appeal from this Judgment within thirty (30) days from the date of entry of this Judgment.

[1575a]

Dated at Philadelphia, Pennsylvania, this 4 day of May 1970.

By the Court:

RALPH C. BODY,
Judge.

Approved as to Form:
HENRY N. PAUL, JR.,
ROBERT B. WASHBURN,
JOHN J. MACKIEWICZ,
Attorneys for Plaintiff.
Attorney for Defendant,
ARTHUR H. SEIDEL.

[1576a]

UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA.

CIVIL ACTION No. 39,056
PROTRACTED CASE

HADCO PRODUCTS, INC.,

Plaintiff,

v.

WALTER KIDDE & CO., INC., SUBSTITUTE DEFENDANT FOR LIGHTING CORPORATION OF AMERICA, INC.,

Defendant.

NOTICE OF APPEAL.

Notice is hereby given that Walter Kidde & Co., Inc., substituted defendant above-named, hereby appeals to the United States Court of Appeals for the Third Circuit from the Final Judgment entered in this action on the fifth day of May, 1970.

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[913a-1608]*

* 913a is the page number of the appendix in the Court of Appeals. 1608 is the page number of the typewritten transcript.

EXCERPTS FROM TESTIMONY IN DISTRICT COURT.

Mr. Seidel: The next witness I would like to call is Mr. Robert Stith.

ROBERT STITH, sworn.

DIRECT EXAMINATION.

By Mr. Seidel:

Q. Mr. Stith, how old are you, sir?

A. 82.

Q. And where do you reside?

A. Manhattan, 405 West 23rd Street, New York City.

Q. And what is your occupation?

A. Designer.

Q. Designer of what type of item?

A. Mainly lighting fixtures.

Q. And by whom are you employed?

A. At the present moment, self-employed.

Q. And what has been your education, Mr. Stith? I think you will have to speak up. I don't think Mr. Paul can hear you too well.

A. I thought I was speaking pretty loud.

The Court: I can tell you you are not speaking

[914a-1609]

loud at all.

The Witness: I am not? Well, I will intensify——

The Court: If you speak too loud, we will stop you, so just talk to the gentleman back there in the audience and then you will be loud. You have the competition of the fans.

A. I went to the Pringy School in Elizabeth until I was about 12. I went to public school in Brooklyn and went for about a year and a half to Erasmus Hall—I was a drop out—and in later years, I studied drawing at various places including about two years in architectural drawing at Mechanics Institute in New York City.

Q. What has been your experience in the field of designing lighting fixtures, and give us briefly a chronological outline starting with your earliest experience.

A. My earliest experience was about a year with the Enos Company. Then I went to Sterling Bronz whom I was with from about 1908 until World War I.

Q. And from 1908 to World War I you were with what company?

A. Sterling Bronze Company.

Q. Sterling Bronze. In what capacity?

A. Designer, draftsman and designer.

Q. Of what?

[915a-1610]

A. Lighting fixtures.

Q. Now, after World War I, by whom were you employed?

A. I was employed by the Cassidy Company.

Q. In what capacity?

A. The same.

Q. Designing lighting fixtures?

A. Yes.

Q. And what years was that approximately?

A. What year was that?

Q. Yes, from what year to what year?

A. Oh, that would be from about '19 to '23, I think.

Q. 1919 to 1923?

A. Approximately.

Q. And where did you go after 1923?

A. With Robert Phillips.

Q. In what capacity?

A. As a designer and producer in charge of their portable lamp division.

Mr. Paul: I didn't hear the name of that last company.

The Witness: Robert Phillips.

Mr. Paul: Robert Phillips? Thank you.

By Mr. Seidel:

Q. Now, how about after 1932?

[916a-1611]

A. After 1932? That was the war years.

Q. No, 1932.

A. Beg your pardon?

Q. 1932.

A. '32? Well, during World War I I was out of the industry for a while.

Q. And then after, from '23, you were with Robert Phillips. Now, where have you been since 1932?

A. Since 1932, the Phillips Company failed during the depression, and I formed a company or a partnership, purchased the patterns of the portable lamps of the Phillips Company and continued that as Plaza Studios until 1942.

Q. And then what did you do during World War II?

A. I worked for Simmonds Air Accessories.

Q. In what capacity?

A. I had charge of their Corsey Control Design.

Q. What control?

A. Corsey Controls, manually operated controls for airplanes.

Q. And after World War II, what did you do?

A. Went back to Cassidy.

Q. That's a lighting fixture company?

A. Same company.

Q. In what capacity?

[917a-1612]

A. Same, lighting fixture company.

Q. In what capacity?

A. That I had been with prior.

Q. In what capacity?

A. The same capacity.

Q. Designer of lighting fixtures?

A. Designer of lighting fixtures and general manager.

Q. And then after you were with—how long were you with Cassidy after World War II?

A. About two years.

Q. And then what have you done?

A. For a short time I was with another concern, Henderson, about a year, and then I went in for free lance designing.

Q. And are you still a free lance designer?

A. Yes.

Q. Of what type of article? Lighting?

A. Mainly lighting, anything to do with ornamental metal work.

Q. Have you ever been employed by Lighting Corporation of America?

A. No.

Q. The defendant in this case?

A. No.

Q. How about any predecessor of the defendant or any

[918a-1613]

corporation affiliated with the defendant?

A. None that were such to my knowledge.

Q. Do you have any stake in the outcome of this litigation?

A. None.

Q. Mr. Stith, what were your duties at Sterling Bronze? You testified you were with Sterling Bronze from 1909 to 1917.

A. Mainly in the design of the fixtures, making drawings. I did some sales work for them.

Q. Have you spent hours on the drafting board, making drawings of lighting fixtures?

A. Many, I would say, years.

Q. What types of lighting fixtures did you design for Sterling Bronze between 1909 and 1917?

A. All types, chandeliers, wall brackets, lanterns, torchaires, portable lamps, practically every type of lighting fixture.

Q. Now, when you say "practically every type," would that be interior lighting?

A. Except——

Q. Except what?

A. Except commercial, as it is known today.

Q. What is commercial as it is known today?

A. Well, I call them shoe boxes.

[919a-1614]

Q. Oh, you mean fluorescent fixtures?

A. Fluorescent type fixtures.

Q. They hadn't been invented yet?

A. No, but——

Q. Would that have included exterior lighting fixtures?

A. Yes.

Q. And interior lighting fixtures?

A. Yes.

Q. Now, what sort of business did Sterling Bronze have in the period that you were with them?

A. Well, their business was to a large extent custom-made goods, although they did have a very large showroom with I would say almost a thousand samples.

Q. How large a staff of lighting fixture designers did Sterling Bronze have in that period?

A. Oh, approximately 15, possibly as much as 20.

Q. What did your work entail in the years you were with Cassidy Company?

A. The same as with Sterling, making drawings of lighting—designs of drawings of lighting fixtures, mainly for special installations.

Q. Mainly for special installations. That would include both exterior and interior lighting fixtures?

A. Correct.

[920a-1615]

Q. Now, can you approximate for us how many lighting fixtures you have designed in the years you have been in the industry since 1909?

A. Thousands I would say.

Q. What sort of manufacturing processes were used to make lighting fixtures in the years preceding 1930?

A. Well, there were larger—in the earlier days of the industry, they were largely handmade. They were practically all hand done. There were no automatic machinery in those years. The castings were hand molded.

Q. Did they have castings in those days?

A. Yes, we had French sand castings and green sand castings were used by some people, but the better firms used nothing but French sand because it was a finer texture, fine grade of casting.

Q. Brass and bronze? How about sheet metal, did they work with that in those days?

A. Indeed they did.

Q. What type of sheet metal was used in those days?

A. Copper, brass, sometimes iron.

Q. Now, with Sterling Bronze and with Cassidy in the periods you were with them, back before World War I and in the years right after World War I, how were the fixtures purchased by the customers? By and large did they buy them from catalogues?

[921a-1616]

A. No, we issued no catalogues. There were no catalogues by those firms at that time or that I ever knew of. We did have photographs of some of our products, the more popular ones.

Q. And what would be done? Would the customer be furnished with these photographs?

A. The customer would usually come into our showroom with a plan of his building or home and look around our showroom and see if he saw something that pleased him. Sometimes he might see something that he would like but he would like to have modified which was done.

Q. And what would be the purpose of the designer when the customers would state, "I want something modified."

A. Why, you would change it to meet the conditions that he would enumerate or desire esthetically, that he would wish.

Q. What sort of changes would you make? For example, would you in the case of—did you deal with lighting fixtures that had roofs?

A. Lanterns, are you talking about?

Q. Yes, lanterns.

A. Yes, sir.

Q. Did you deal with lighting fixtures that had cages, lanterns, that had cages?

A. All lanterns I think have cages.

[922a-1617]

Q. Okay. Did they have four-sided cages in those days?

A. We had square cages, hexagonal cages, square over a chamferred corner, octagonal sometimes, round, and a large vent.

Q. Did it involve much for a lighting designer of that period to go from one type of cage to another?

A. I wouldn't think so.

Q. Well, did you as a matter of routine do that in that period?

A. You mean modify the size or——

Q. Modify the size or the shape or the type of cage from one type to another?

A. That is frequently done.

Q. Frequently done? How about the roof, did you work with lanterns that had different types of roofs?

A. Naturally.

Q. Well, did you work with lanterns that had straight sided roofs?

A. Yes.

Q. And did you work with lanterns that had curved roofs?

A. Right, both convex and concave.

Q. Convex would be a dome shaped roof?

A. The dome shaped roof.

Q. And a concave roof—would you call the roof shown in

[923a-1618]

the patent in suit in Figure 1 of the patent in suit, a concave type of roof?

A. Right.

Q. In other words, the curvature of the roof forms a concavity at the—when viewed in profile?

A. I would say so.

Q. Now, did the lighting designers of that period work with all these different types of roofs, concave, convex, straight, in lanterns?

A. Assuredly.

Q. And were they frequently called to modify one roof into another type?

A. Not frequently, but it was done.

Q. It was done? And it was actually done in metal? In other words, the designer did it and someone made a lantern like he designed it; is that correct?

A. Correct.

Mr. Paul: Well, when you get to opinions, don't lead the witness quite as much as you are, please.

Mr. Seidel: Okay.

Mr. Paul: You are putting all sorts of words in his mouth.

By Mr. Seidel:

Q. Now, did you work with finials back in that period

[924a-1619]

before World War I and right after World War I—and by "finial," we are referring to everything above the vent cap?

A. Right, naturally. Finials are used on many fixtures.

Q. As far back as you can remember were finials known?

A. What?

Q. As far back as you can remember were finials known on fixtures?

A. Ever since I have been in contact with the business there were finials around.

Q. How many finials have you seen in your career as a lighting designer?

A. Innumerable.

Q. And was it common to change the finial from one fixture to another?

A. There was frequently finials that fit many applications, interchangeable.

Q. Now, I use the words "vent cap" to refer to the element designated "C" in Defendant's Exhibit 70. Did you call those vent caps or did you have another name?

A. We call them cowls, I believe.

Q. Cowls?

A. Cowls.

Q. Would you mind spelling that? Cowl? C-o-w-l?

A. What?

[925a-1620]

Q. C-o-w-l?

A. Yes.

Q. That was the name for it back in that period?

A. That's what we called them.

Q. And were they common in lighting fixtures and lanterns?

A. They were frequently used.

Q. Now, was it common in that period to have a relationship between the shape of the cowl or vent cap and the shape of the roof?

A. Usually there was a continuity of line but—

Q. What do you mean by that?

A. On occasion—

Q. What do you mean by that?

A. Follow—the contour of the cowl followed the contour of the top of the lantern.

Q. So that it was usual in the designs of that period to have some degree of conformity in the contour between the vent cap or cowl and the contour of the roof; is that right?

A. Correct.

Q. Now, in connection with the roofs of that period used on lanterns, was it common to have the peripheral edge of the roof wavy with a sinuous curve as shown in Figure 1 of the patent in suit?

A. It was frequently done because it was, I think, the

[926a-1621]

cheapest and easiest decoration that could be put there.

Q. It was frequently done?

A. Frequently done.

Q. Now, was it frequently also done in connection with the cowl or vent cap?

A. If the bottom of the fixture was so done it was frequently done also on the vent cap.

Q. I see. So in other words, if the bottom of the roof, the peripheral edge of the roof, had this sinuous curve, it was frequently done to put the same sinuous curve in the vent cap; is that it?

A. I would phrase it another way. We had——

Mr. Paul: Why not ask the witness questions instead of giving answers.

Mr. Seidel: I am just summarizing.

Mr. Paul: I know, but he is an expert in this field. You have qualified him as having a lot of experience.

Mr. Seidel: Okay. I won't summarize any more.

By Mr. Seidel:

Q. How about what we have called in this case triangular accents? I will point to one of them in Defend-

ant's Exhibit 70 on the roof, and I will label that "TA." Were they used in the period in which you designed lighting fixtures before the first World War?

• • •

[927a-1625]

The Court: And now, then, he talked about the triangular accents were indented rather than—

They were indented; is that right?

The Witness: Well, sir, they laid the edge of the lantern on a piece of gutta percha and in those days they had artisans that could just—they had a tool we might say looked like a miniature sledge hammer, and they just strike it like that, to give the indent, and come along and hit the next one. Then the space in between—

The Court: The indentation, it was an indentation as a result of hitting with the hammer?

The Witness: But the space in between would naturally take that curve and the accent is accomplished.

The Court: In other words, take a ball peen hammer and hit it?

The Witness: No, it was like a sledge, almost like a cold chisel on one end.

The Court: Oh, yes.

The Witness: And strike it and get the indent, strike the next one, and the space in between that naturally would curve as—

By Mr. Seidel:

Q. I show you D-95. Would they in that period make sinuous curves as shown in D-95 in sheet metal?

[928a-1626]

A. They could have done that but normally—that could be obtained, but that probably would be obtained with a ball peen hammer.

Q. With a different type of hammer?

A. Different type of hammer.

Q. But they could make them triangular accents such as shown in Figure 1 of the patent in suit?

The Court: No, he didn't say that.

Mr. Seidel: Oh, all right. Let me ask him that.

The Court: He didn't say that. That's why I asked him to repeat for me the question and the answer.

And you said they used a pointed hammer. I suppose if we take a pick—

The Witness: It was like almost the edge on it, like a cold chisel.

The Court: Like a cold chisel with a handle on it?

The Witness: And I think they had these handles of various sizes and lengths to do the things they wanted.

The Court: Depending on the thickness of the metal?

The Witness: The thickness of the metal, the

[929a-1627]

depth of the niche they wanted. Sometimes they would take—if they wanted to get a long slot in it and make it a little deeper, go in deeper, they might take a cold chisel and—like a cold chisel—and hammer along that way to get the same effect.

The Court: This was done before the metal was shaped?

The Witness: No, it was usually all shaped by the time that was done.

The Court: Shaped by that time?

The Witness: Yes. In the case of a hexagonal lantern, it was usually done in panels. When they were curved, they had—

The Court: With a hexagonal lantern, it was then molded or soldered together?

The Witness: Straight roof, they just bolted it. If it was a roof that was curved like that, there was a pattern made and it was cut to that and then formed and soldered together or riveted together and then the edge would be done as a ledge, the last operation, I would say, in either one of those lanterns.

The Court: I think I understand it.

Mr. Seidel: Okay.

The Court: I think that's all we will have this

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[930a-1628]

AFTERNOON SESSION.

ROBERT STITH, resumed.

DIRECT EXAMINATION (Cont'd).

By Mr. Seidel:

Q. Mr. Stith, just before lunch you were testifying regarding these impressions made in the roof. What portion of the roof is struck by the hammer, could you tell us?

A. The underside.

Q. The underside of the roof? So on the outside of the roof there is a bump; is that correct?

A. The point comes up, it is a natural formation of a curve.

Q. And you have been using the word "lantern," Mr. Stith. I show you Defendant's Exhibit 243 which is a Progress 5607 fixture. Would you call that a lantern within your terminology?

A. It is a bracket lantern.

Q. It is a what lantern?

A. Bracket lantern.

Q. A bracket lantern? And I show you Progress fixture P5407 which is Plaintiff's Exhibit 24 and would you also call that a lantern?

A. A lantern, yes.

[931a-1629]

Q. Now, did the roofs of the fixtures with which you worked more than 30 years ago have ventilators?

A. Yes.

Q. What types of ventilators?

A. Sheet metal ventilators, the same as on any—in a majority of cases.

Q. You will have to speak up.

A. Sheet metal, the same as the body of the lantern, the roof of the lantern is made of.

Q. Were there different types of ventilators used on the fixtures of that period?

A. They may vary slightly in form.

Q. Well, what types of variations would there be?

A. Oh, some would be triangular like one of these items, some would be of a roundish nature like on the other fixture alongside it.

Q. When you pointed to triangular ventilators, were you pointing to Progress P5407, Plaintiff's Exhibit 24?

A. That fixture.

Q. That has what you would call a triangular ventilator?

A. Yes.

Q. And when you referred to a roundish ventilator, were you pointing to—

A. That, I am referring to.

[932a-1630]

Q. —the fixture of the plaintiff, the one that I have in my hand which is their Tudor fixture, Plaintiff's Exhibit 23?

A. Correct.

Q. And what relationship did the ventilators bear to the surface of the cage in this period of 30 years or more ago?

A. In what respect do you mean?

Q. Well, in respect to following the surface of the cage.

A. They generally followed it.

Q. Following the surface of the roof, I am sorry.

A. They generally followed the contour of the roof. They had to.

Q. They had to?

A. I would say so.

Q. Why?

A. Because of the conformation.

Q. Now, have you seen lanterns where the number of sides of the roof was different from the number of sides of the cage?

A. On occasion.

Q. How far back did you see such lanterns?

A. Well, I will say a long while back. Just how far I couldn't say but I am sure—

Q. More than 20 years ago?

A. More than that, 40 years ago.

[933a-1631]

Q. 40 years. Do you have an opinion as to whether unusual designing skill is required to change a straight-sided roof to a concave roof?

A. Please repeat that?

Q. Do you have an opinion as to whether unusual designing skill is required to change a straight-sided roof to a concave roof?

A. To modify the design? No.

Q. In your opinion would this be within the skill of an ordinary designer?

A. I should think most any fixture draftsman or designer could do such a job without much trouble.

Q. Do you have any opinion as to whether it would require more than the ordinary skill of a lighting fixture designer to make the Progress P5607 fixture exemplified by Defendant's Exhibit 243 which I show you?

A. No, I shouldn't think.

Q. From Progress lighting fixture 1421 shown at Page 26 of Defendant's Exhibit 80?

A. Yes.

Q. Do you have an opinion as to whether it would take more than the skill of an ordinary designer to convert from the straight roof of Progress fixture 1421 to the curved roof of Progress fixture P5607?

[934a-1632]

A. No, I do not think it would be very difficult.

Q. It wouldn't be very difficult? If the roof were curved as in P5607 what would happen to the ventilators?

A. In the old days, you want to know, are you talking about, or what?

Q. Yes, if they curved the roof as in P5607, what did they do to the ventilators?

A. They would probably knock them out of the body of the roof.

Q. Would the ventilators be curved or straight?

A. They were brought right out of the form of the roof up the lantern.

Q. And what would their configuration be? Would they follow the shape of the roof?

A. They would have to follow the shape of the roof.

Q. Now, I show you a photograph which is Item 7 in Defendant's Exhibit 210, namely, the photograph of the fixture installed at the St. James Lutheran Church, and I wish you would have that in front of you, and I ask you, Mr. Stith, in your opinion would it be novel in view of the showing of the fixture in that photograph to add a matching vent cap or cowl to the Progress fixture, P5607?

A. No, I should not think so.

Q. And what in your opinion would be the form of the vent

[935a-1633]

cap if one were to add it to P5607 in the base of Item 7 of D-210 which is in front of you?

A. Well, it would probably follow the continuity of the body. It would nine times out of ten. Once in a great while they might put one on as a different form as an accent note, but it is not often done that way.

Q. When you said in your testimony that you would knock the ventilator out of the roof, did you mean that in those days they would knock the ventilator out of the roof? What did you mean by that, Mr. Stith?

A. Well, it would be much too expensive to make a ventilator on a curved roof, and form it and attach it to

the roof, so what they generally did was put a slit through the roof and where they lifted up the top by hammering it up, and it would take it—a form somewhat similar to this kind of ventilator that you have got on this lantern, the next one.

Q. This one?

A. Yes. It would be quite similar to that in form.

Q. How would they seal the top of the ventilator?

A. They didn't have to seal it. It was already sealed. It was a part of the roof of the lantern.

Mr. Seidel: I see.

I have no further questions, Your Honor.

You may cross examine.

[936a-1634]

CROSS-EXAMINATION.

By Mr. Paul:

Q. Mr. Stith, you spoke of an employment with Sterling Bronze, with Phillips, with Cassidy and if I heard you correctly, with Henderson; is that right?

A. Yes.

Q. As to all of those companies with which you were associated were they all engaged in doing custom work?

A. The first three were; the last mentioned, to some extent.

Q. The last being Henderson?

A. Yes. I was only with them a very short time.

Q. Yes. As to Sterling Bronze and Phillips and Cassidy was their custom work mostly for what we will call either monumental buildings or fairly expensive residential buildings as contrasted with the modern, inexpensive ranch house, shall we say?

A. I would say mainly they were in building residences costing about in those days—about $25,000 and up, and some monumental buildings also as the New York Public Library, Grand Central Station and others of that ilk, some hotels, and plenty of—but the bulk—the volume would be in residential buildings.

Q. And were those of these jobs done then to a made-to-order basis to satisfy the particular desires of that customer?

A. The architect, we usually work in close conjunction with

[937a-1635]

the architect as to the style, type of fixture that he wanted for the various locations. Then we would prepare sketches for his approval.

Q. You would get from the architect the general character that was desired and then work from there?

A. Well, we got some from the drawings. He presented us with the drawings. We recognized the style of the building.

Q. Yes.

A. And we knew to a large extent what would be required, but we would also verify that with the architect.

Q. Would you consider that most of your work was in the area of original design?

A. I would say mostly.

Q. And when you would make an original design in this period, would you go about it by picking out of catalogues a finial from one lantern and a vent cap from another and a roof from another and then putting them together?

A. As far as we were concerned we paid no attention to catalogues. We had a library of 200 or more books on

various types of architecture, metal work, and that sort of thing.

Q. Yes.

A. We did not have to consult—we considered ourselves beneath copying anybody. Once in a while things were reproductions or adaptations of truly styled things.

[938a-1636]

Q. Does that mean, then, that as you made your styles, you considered them to be a unitary composition?

A. What do you mean by "unitary composition"?

Q. Well, what I am trying to find out is, in what you call an original design, do you take a known finial and a known vent cap and a known roof and put those three together and call it original design?

A. No.

Q. Or do you set about to make a unitary composition, designing a finial to go with the vent cap, to go with the roof?

A. My opinion is, sir, that very few ornamental designs of true nature are original; they are adaptations, they are rescaled or reformed to meet conditions.

Q. Well, what I am trying to find out is, when you make what you call an original design, do you attempt to make a unitary composition of your own with a finial, a vent cap, a roof, a cage? Do you fit them together into a unitary composition?

A. Naturally, it is natural, I would say, to do such.

Mr. Paul: Read it back to me?

(The answer was read.)

Q. And you would try to make all of these elements harmonize with each other, to form the total effect that you had in mind, would you not?

A. Naturally.

[939a-1637]

Q. Did these companies have these various elements in stock so they could go to a bin and pick out a vent cap and a finial?

A. We did not. In some instances, in some minor things, we might, when we were running an item in foundry, want some extras, but we had a pattern vault in which patterns of all our castings were kept and the spinning department, the chucks were down there, go down and see if you could find a chuck to fit your requirements. There were no stampings to speak of in those days. In the early days, they were mostly spinnings or made by hand out of sheet metal.

Q. Well, then, when you would make an original design you would not go to a bin and pull out a finial and go to another bin and pull out a vent cap and put the two together, but you would start on a piece of paper, drawing what you conceived to be appropriate for the occasion, would you not?

A. What the usual procedure would be, to make a quarter scale rough-out, one-quarter full size rough-out. Then you go and look in the pattern vault or in the chucks or whatever was necessary to look for, to see what you had that would approximate what you had, and then you might alter that design to fit something that you had or a form, spinning form, a chuck, as they call them, or if it was a casting, a cast part.

Q. And for this purpose would you have in front of you the drawings of others or the catalogues of others or the

[940a-1638]

materials of others to keep them together?

A. No, sir.

Q. In other words, you didn't go about your design in the manner of a mosaic, putting together pieces from one lantern with pieces from another?

A. Not that I can ever recall.

Q. I think you said, Mr. Stith, that there were thousands of different types of finials in existence during this period of your work with these companies?

A. I said I should imagine so, among all the manufacturers, we probably had in our place, in Phillips and Sterling, a couple hundred, maybe 500. I don't know how many.

Q. For instance, looking at Plaintiff's Exhibit 114A, to you this would represent just one finial out of thousands of finials that were available during this period?

A. Rather a commonplace form, I would say, in representation of a steeple, steeple top.

Q. There would be thousands of other forms?

A. There would have been hundreds of other forms. I am just saying between the whole industry, there would be thousands.

Q. Yes.

A. In my particular case, there would be a few hundred.

Q. Yes. Now, coming to what we have called the vent cap—and I think you called the cowl—

[941a-1639]

A. Right.

Q. —would it also be true that there would be innumerable designs of cowls that were available to you?

A. There were nothing available. Those things were usually made by hand. There was no reason to have any specimens going around.

Q. Were all of these cowls the same or did they differ from each other, whether they—

A. They differed from each other and at times, yes, they were made for the individual lantern for which they were designed or to be constructed therewith.

Q. What I am getting at, was there a great variety of designs?

A. There was as many kinds of designs as lanterns which carried cowls.

Q. Now, would the same be true of the contour of the roof, shall we say, that there were thousands of different roof contours that were available?

A. Quite a few different contours of roofs, yes.

Q. And would the same be true of the cage, that there were thousands of different cages available in their detailed proportions?

A. There were innumerable cages, I would say, because they were all handmade. They could have varied in size and form

[942a-1640]

with relative ease.

Q. And how about the bases, were there innumerable forms of bases?

A. There would be quite a few chucks around, in that general form, which you could spin a base of that nature from.

Q. Would that mean, then, that with these innumerable forms of finials, innumerable forms of vent caps, innumerable forms of roofs and of cages and of bases, that the chances of two designers hitting upon the identical design of finial, vent cap, roof, cage and base would be rather astronomical?

A. I wouldn't say it was astronomical but—

Q. Do you know the formula of the laws of choice and chance?

A. I don't know the formula exactly, no. I think it would be quite possible for a fixture designer that was brought up in my era who had so much experience, was well experienced, to have certain lines so ingrained in him that they would come out automatically almost.

Q. Mr. Stith, you have spent a good portion of your rather long life in designing lighting fixtures, have you not?

A. Indeed.

Q. And these various companies with which you have been associated have had a very fine reputation in the field of new and original lighting fixtures, have they not?

A. Unquestionably.

[943a-1641]

Q. And I would certainly not be exaggerating, would I, if I called you a designer of long experience and unusual skill?

A. Long experience I will accept; unusual skill is open to question.

Q. Has anybody questioned your skill in the course of your career, sir?

A. There have been times.

Q. You have talked about ventilators of different shapes and how ventilators have been applied to roofs. Do you have with you any example of the type of ventilator that you were talking about in your direct examination that, let us say, would differ from the ventilators that are shown in the various books that are here in evidence.

What I want to find out, Mr. Stith, is whether you were in your testimony trying to indicate that there was some different type of ventilator that we haven't seen here in these books, or whether you will accept what are in these books as representative—

A. In general I will accept them.

Q. The answer was—?

A. In general I will accept them.

Q. Because if there is any different ventilator that you have in mind that has not been shown in these books—and I mean Plaintiff's Exhibits 128, 129, 130—I would like to have

[944a-1642]

you make reference to it and where it may be found and where it may be seen.

Mr. Seidel: Your Honor, there is no foundation that this witness has ever seen these books, 128, 129 or 130. He is asking him to produce something and I expressly stated the witness brought nothing with him today. I don't think that's a proper question.

The Court: I don't know. If you said it I don't know when you said it. You are just saying it now for the first time.

Mr. Seidel: Your Honor, I thought I said before lunch when Mr. Paul was asking what I was bringing him out for, I said I am not offering any exhibits through this witness

The Court: Well, that's a little different, isn't it?

Mr. Seidel: That's what I meant, Your Honor.

By Mr. Paul:

Q. Let me ask you, Mr. Stith, have you seen any of these exhibits that are in these books?

A. I have noticed some of—

Q. Plaintiff's Exhibits 128, 129 and 130A?

A. I don't know them by number. I have seen them in general. I don't know where to find them. Where am I going to find them?

[945a-1643]

Q. I just want to know whether you have looked through these various books?

A. I have looked through some of them, I think. I wouldn't say all of them.

Q. Now, all I wanted to find out from you, Mr. Stith, was that when you referred to certain ventilators of certain shapes, do you have in mind any specific drawing, any specific fixture, anything different from what is shown in these various books?

A. Are you speaking now in size and proportion or something of that sort or general form?

Q. Well, I am just speaking of what you were talking—what you had in your mind at the time you testified about these ventilators.

A. I say in general form, these were the specific types of ventilators that were generally used.

Q. Yes.

A. There may have been some with slightly different conformation. I do not recall exactly what they were at this time.

Q. And when you spoke of hammering up from the inside, I think, with a chisel or some other tool—

A. Yes.

Q. —to produce bumps on the outside of the edge of the roof, do you have anything here to illustrate what you were

[946a-1644]

talking about?

A. No, sir, but may I say—

Q. Yes.

A. —these lanterns are more or less, all of them, adaptations of the old sheet metal lanterns as far as I see them. I see no difference in their general confirmation or in the method used for their decoration than there was in the old sheet metal lantern.

Q. And would you say that your work generally is not creating new designs but simply making adaptations of existing old designs; is that your work?

A. I claim there was practically nothing new under the sun designed by us.

Q. Well, I think Ecclesiastes claimed the same thing many thousands of years ago.

A. You can always go back and find prior art, most anything.

Q. As a matter of fact, all a man can work with are the tools that God gave him; isn't that right?

A. Correct.

Q. And therefore when anything is created, all we do is put together existing elements in different regrouping and re-arrangement?

A. We may re-arrange their proportion and alignment. If something is more pleasing to us or to fit, if the lantern is to

[947a-1645]

fit a certain area, to make it conform to the shape of that area, it looks better that way.

Q. But your object is to create an overall pleasing effect, is it not?

A. Naturally.

Mr. Paul: That's all.

Mr. Seidel: I have no question, Your Honor.

The Court: Thank you, Mr. Stith. You may step down

Dec. 11, 1928.

Des. 77,196.

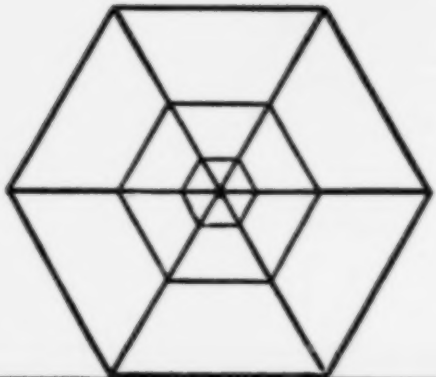
W. UNDERWOOD

LANTERN FOR LIGHTING POSTS

Filed Sept. 12, 1928

Fig. 1

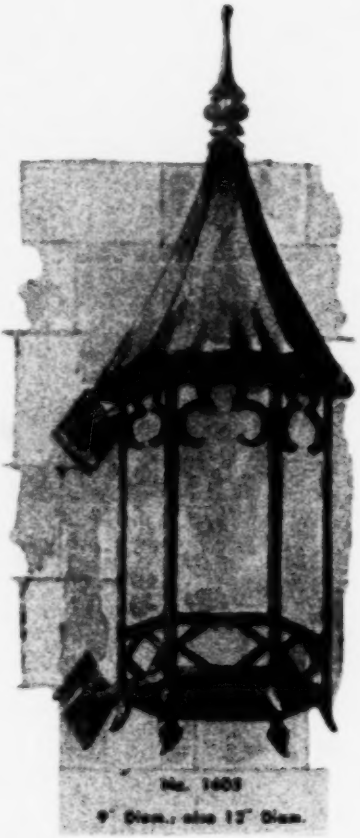
Fig. 2.



Inventor
Western Underwood
By W. H. Mitchell

Item No. 1605 on Page 4, Meierjohan Wengler Ornamental Lighting Fixtures and Lanterns Catalog, dated 1953, Cited by Patent Office (PX128)

A85



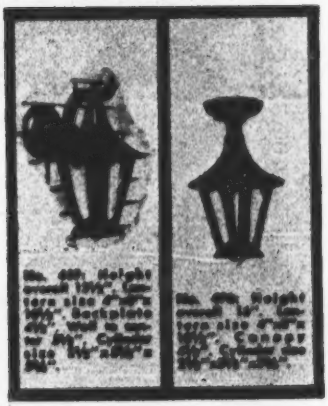
Item No. 10576 on Page 5, Meierjohan Wengler Ornamental Lighting Fixtures and Lanterns Catalog, dated 1953, Cited by Patent Office (PX128)

No. 10576
10" Diam. at Bottom
36" High.

RESIDENTIAL LIGHTING

Kidde's Item No. 3, Fixture No. 1421 on Page 26 of Progress Catalog 40, dated 1946 (Ex. D80)

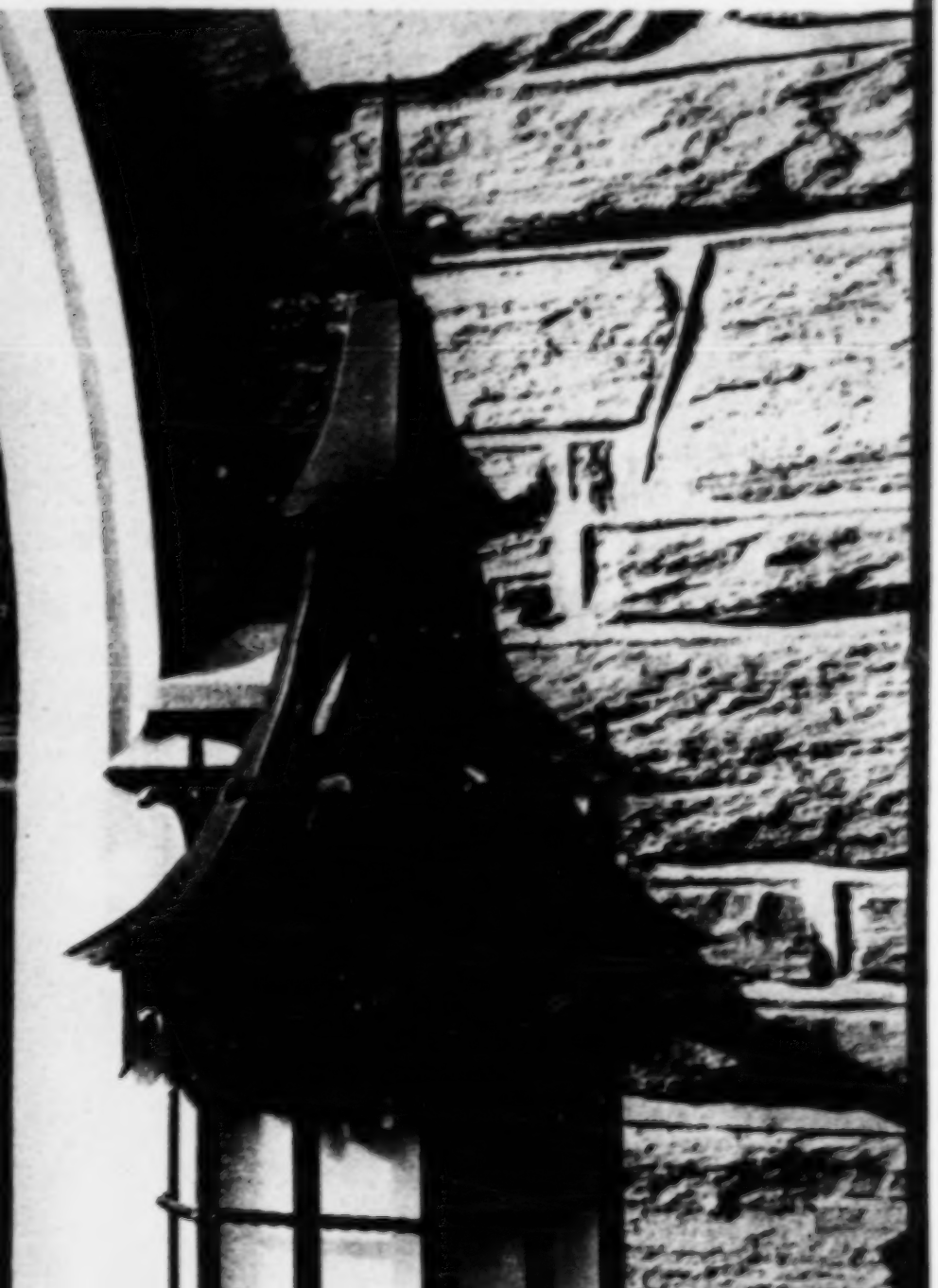
Kidde's Item No. 5, Fixtures Nos. 469, 470 and 0472 on Page 17 of The Herwig Company Catalog 60, dated 1958 (Ex. D139)



No. 0472. Height overall 23½". Lantern size 4" x 6½". Wall to center 7½". Cylinder size 2½" x 3½" x 5½". Maximum Watt. 100W.

Kidde's Item No. 6, Photographic Enlargement of Fixture No. 469 on Page 17 of Herwig Catalog 60 (Ex. D 191)

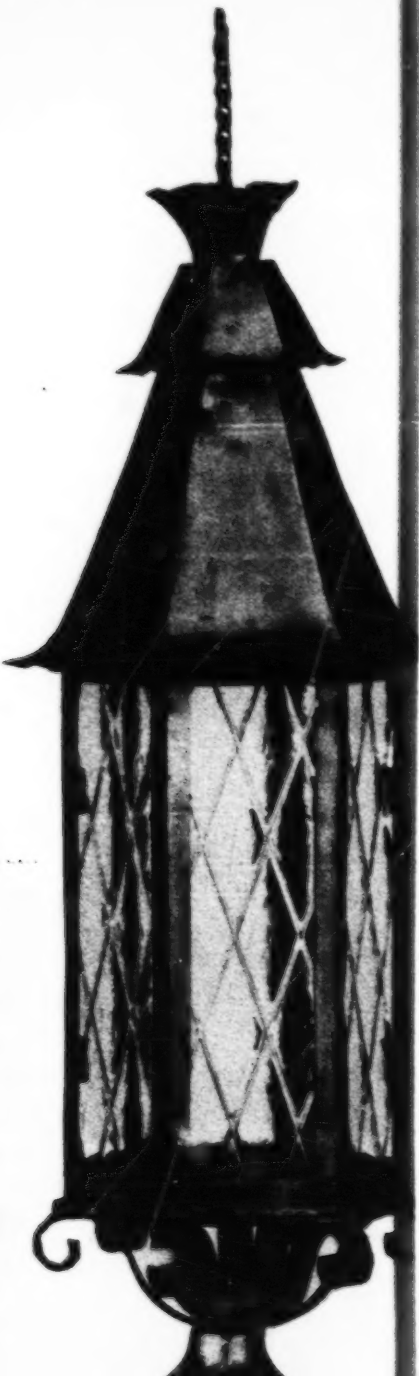
Kidde's Item No. 7, Photograph of Fixture Installed in 1957 at St. James Lutheran Church, Phila.,Pa. (Ex. D177)



Kidde's Item No. 13, Fixture No. 466-Hex. A92
Post Lantern on Page 58 of Novelty Lighting
Corporation Catalog 49, dated 1935 (Ex. D146)

466 - HEX. POST LANTERN
Roof Dia. 7" Base Dia. 5"
Height O A 17" Lights 1
Finish Old Copper
Glass Amber Mica

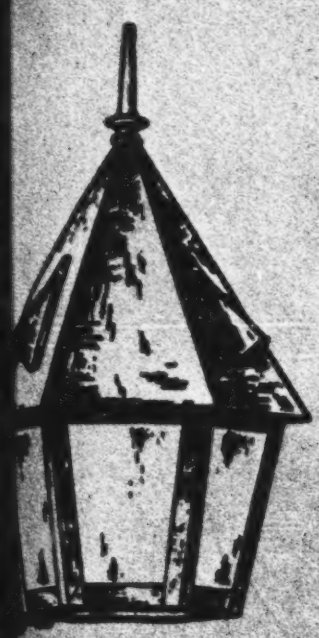
Kidde's Item No. 16, Photographs of a Hadco Lantern Sold in 1961 (Exs. D53, 55)



Kidde's Item No. 17, Fixture No. 368 on Page 73 of The Novelty Lighting Catalog 49, dated 1935 (Ex. D146)

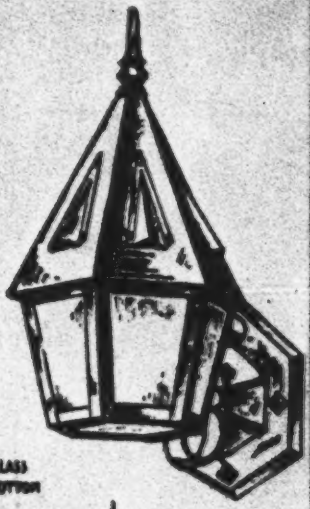
HX 368 - PEND. & LANTERN
Lgth. O. A. 30"
368 - HEX. LANTERN ONLY
Roof Dia. 8" Hght. 12"
Lights 1.
Finish. Black.
Glass: Clear Mica

METROLITE

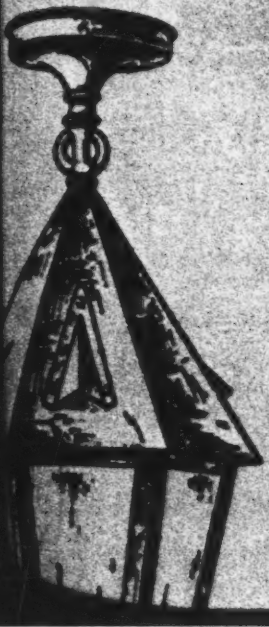


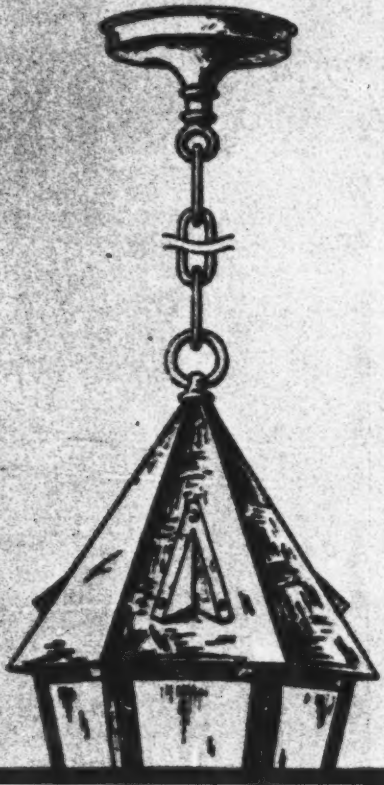
№1260

№47

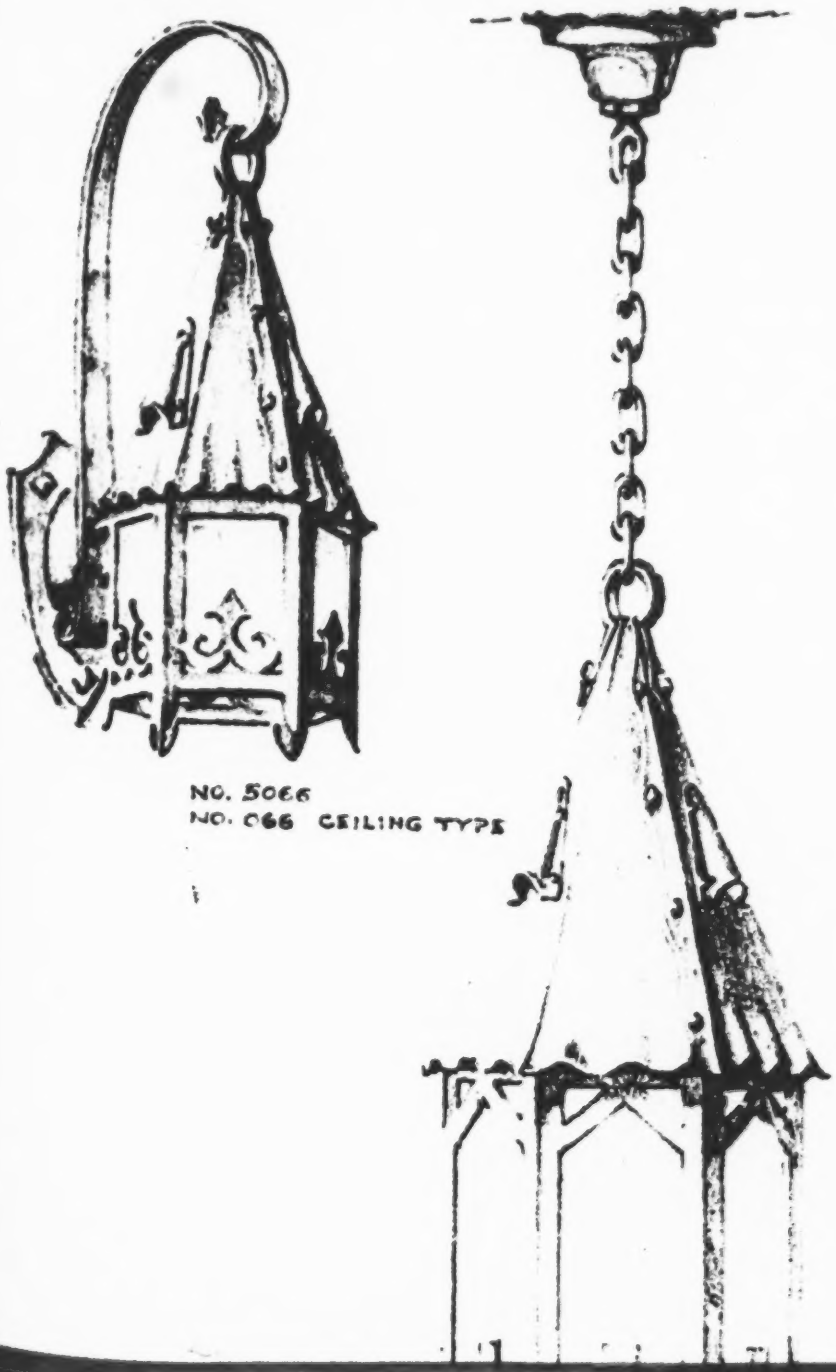


№45



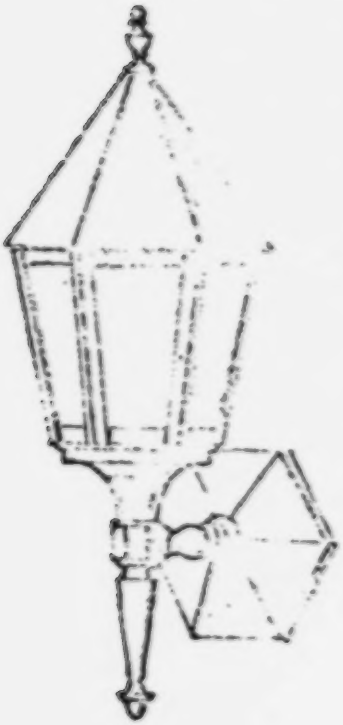


Kidde's Item No. 19, Fixture Nos. 066 and 067 on Page 18 of Gruber Brothers Three "G" Lighting Catalog No. 35, dated 1935 (Ex. D143)



Kidde's Item No. 21(A), Enlargement of Photograph from Metalwork Scrapbook (Ex. D184)

Kidde's Item No. 22, Fixture No. 363 on Page 25 of Gruber Brothers Three "G" Lighting Catalog No. 35, dated 1935 (Ex. D143)



No. 363

DESIGNS

AUGUST 22, 1972

224,632
WOMAN'S SHOE
Wiley Robert Ecton, Towson, Md., assignor to Dixon-Bartlett-Lambrecht, Inc., Baltimore, Md.
Filed Sept. 29, 1970, Ser. No. 25,262
Term of patent 7 years
Int. Cl. D2—*04*
U.S. Cl. D2—297

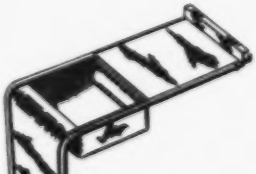
224,633
CHAIR
Frederick G. Kohl, Brooklyn Heights, and Robert K. Marceca, Chappaqua, N.Y., assignors to Rio Enterprises Incorporated, New York, N.Y.
Filed Aug. 6, 1970, Ser. No. 24,353
Term of patent 14 years
Int. Cl. D6—*02*
U.S. Cl. D6—12

224,634
A-SHAPED CHAIR
Frederick G. Kohl, Brooklyn Heights, and Robert K. Marceca, Chappaqua, N.Y., assignors to Rio Enterprises Incorporated, New York, N.Y.
Filed Aug. 6, 1970, Ser. No. 24,354
Term of patent 14 years
Int. Cl. D6—*02*
U.S. Cl. D6—12

224,635
CHAIR
Arthur F. Yuenger, P.O. Box 2656, Aspen, Colo. 81611
Filed Aug. 28, 1970, Ser. No. 25,212
Term of patent 14 years
Int. Cl. D6—*02*
U.S. Cl. D6—56

224,636
TABLE
Douglas C. Ball, Senneville, Quebec, Canada, assignor to Massey-Ferguson Industries Limited, Toronto, Ontario, Canada
Filed Oct. 7, 1970, Ser. No. 25,422
Term of patent 14 years
Int. Cl. D6—*03*
U.S. Cl. D6—177

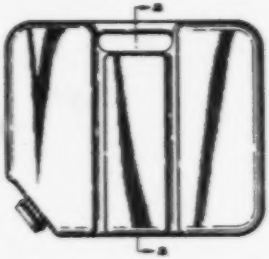
224,637
SIDE EXTENSION UNIT FOR A DESK
Douglas C. Ball, Senneville, Quebec, Canada, assignor to Massey-Ferguson Industries Limited, Toronto, Ontario, Canada
Filed Oct. 7, 1970, Ser. No. 25,371
Term of patent 14 years
Int. Cl. D6—*04*
U.S. Cl. D6—199



Official Gazette Vol. 901, p.1500 A100

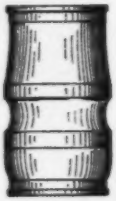
224,638
BOTTLE
Howard Cooper, 175 E. Delaware, Suite 7707, Chicago, Ill. 60611
Filed Nov. 12, 1971, Ser. No. 198,494
Term of patent 14 years
Int. Cl. D9—01
U.S. Cl. D9—23

224,639
LIQUID CONTAINER
Warren J. Schlosser, Columbus, and Jere C. Marsh, Worthington, Ohio, assignors to The Corrugated Container Company, Columbus, Ohio
Filed May 7, 1971, Ser. No. 141,454
Term of patent 14 years
Int. Cl. D9—03
U.S. Cl. D9—175



224,640
CAN OR SIMILAR ARTICLE
Carmen T. Mascia, Westmont, and Richard B. Bagguley, Dolton, Ill., assignors to Continental Can Company, Inc., New York, N.Y.
Filed May 28, 1971, Ser. No. 148,283
Term of patent 14 years
Int. Cl. D9—03
U.S. Cl. D9—216

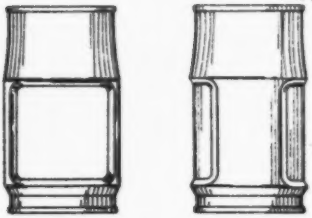
224,641
CAN OR SIMILAR ARTICLE
Carmen T. Mascia, Westmont, and Richard B. Bagguley, Dolton, Ill., assignors to Continental Can Company, Inc., New York, N.Y.
Filed May 28, 1971, Ser. No. 148,284
Term of patent 14 years
Int. Cl. D9—03
U.S. Cl. D9—216



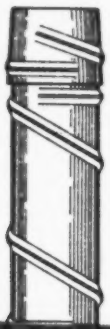
224,642
CAN OR SIMILAR ARTICLE
Carmen T. Mascia, Westmont, and Richard B. Bagguley, Dolton, Ill., assignors to Continental Can Company, Inc., New York, N.Y.
Filed May 28, 1971, Ser. No. 148,299
Term of patent 14 years
Int. Cl. D9—03
U.S. Cl. D9—216

224,643
CAN OR SIMILAR ARTICLE
Carmen T. Mascia, Westmont, and Richard B. Bagguley, Dolton, Ill., assignors to Continental Can Company, Inc., New York, N.Y.
Filed May 28, 1971, Ser. No. 148,300
Term of patent 14 years
Int. Cl. D9—03
U.S. Cl. D9—216

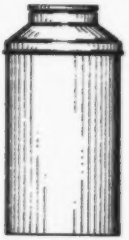
224,644
CAN OR SIMILAR ARTICLE
Carmen T. Mascia, Westmont, and Richard B. Baggaley, Dolton, Ill., assignors to Continental Can Company, Inc., New York, N.Y.
Filed June 14, 1971, Ser. No. 152,829
Term of patent 14 years
Int. Cl. D9—*03*
U.S. Cl. D9—216



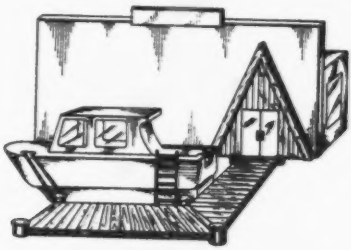
224,645
CAN OR SIMILAR ARTICLE
Carmen T. Mascia, Westmont, and Richard B. Baggaley, Dolton, Ill., assignors to Continental Can Company, Inc., New York, N.Y.
Filed June 14, 1971, Ser. No. 153,134
Term of patent 14 years
Int. Cl. D9—*03*
U.S. Cl. D9—216



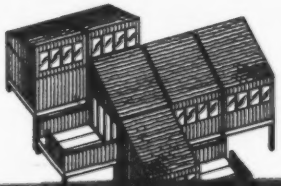
224,646
CONTAINER FOR BEVERAGES OR THE LIKE
Verner Vollquartz, Pontiac, Mich., assignor to Ex-Cell-O Corporation, Detroit, Mich.
Filed June 4, 1971, Ser. No. 150,268
Term of patent 14 years
Int. Cl. D9—*03*
U.S. Cl. D9—218



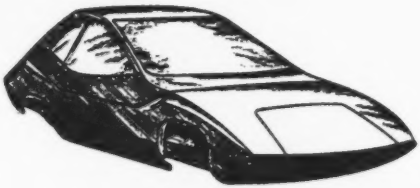
244,647
BUILDING BLOCK
Stanton L. Friedman, 11535 Renwick, Houston, Tex. 77035
Filed Mar. 19, 1970, Ser. No. 21,977
Term of patent 14 years
Int. Cl. D25—*03*
U.S. Cl. D13—1



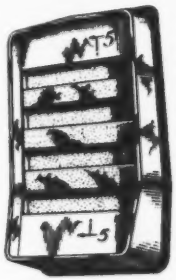
244,648
PRE-ASSEMBLED MODULAR HOUSING STRUCTURE
Edward D. Kelbish, New York, N.Y. (280 Vanderbilt Ave., Brooklyn, N.Y. 11205)
Filed May 26, 1971, Ser. No. 147,303
Term of patent 14 years
Int. Cl. D25—*03*
U.S. Cl. D13—1



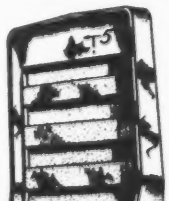
244,649
AUTOMOBILE BODY
Robert S. McKee, 411 W. Colfax St., Palatine, Ill. 60067, and Michael D. Williams, Roselle, Ill.; said Williams assignor to said McKee
Filed Nov. 16, 1970, Ser. No. 26,013
Term of patent 14 years
Int. Cl. D12—*08*
U.S. Cl. D14—3



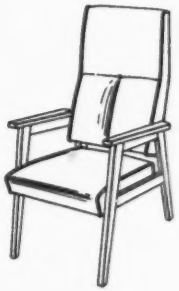
224,650
COMBINED GRILLE AND PERIPHERAL GASKET FOR A TRACTOR
Leo J. Lorenz, Farmington, and Wilford E. Bean, Southfield, Mich., assignors to Massey-Ferguson Inc., Detroit, Mich.
Filed Aug. 6, 1970, Ser. No. 24,348
Term of patent 14 years
Int. Cl. D12—*09*
U.S. Cl. D14—18



244,651
GRILLE FOR A TRACTOR
Leo J. Lorenz, Farmington, and Wilford E. Bean, Southfield, Mich., assignors to Massey-Ferguson Inc., Detroit, Mich.
Filed Aug. 6, 1970, Ser. No. 24,350
Term of patent 14 years
Int. Cl. D12—*09*
U.S. Cl. D14—18



224,652
CHAIR
Harry Zellick, 86 Hyde Ave. 02158, and Louis H. Zellick, 106 Withington Road 02160, both of Newton, Mass., and Phillip Zellick, Boston, Mass. (47 Nottinghill Road, Brighton, Mass. 02135)
Filed Mar. 4, 1971, Ser. No. 121,226
Term of patent 7 years
Int. Cl. D6—*02*
U.S. Cl. D15—1



224,653
VITAMIN TABLETS OR SIMILAR ARTICLE
Robert R. Wiethop, Evansville, Ind., assignor to Mead Johnson and Company, Evansville, Ind.
Filed Apr. 2, 1971, Ser. No. 130,874
Term of patent 14 years
Int. Cl. D1—*01*; D28—*01*
U.S. Cl. D16—3

224,654
WATER CONDITIONER
Donald S. Campbell, St. Paul, Minn., assignor to Ecodyne Corporation
Filed Mar. 24, 1971, Ser. No. 127,478
Term of patent 14 years
Int. Cl. D23—*01*
U.S. Cl. D23—3

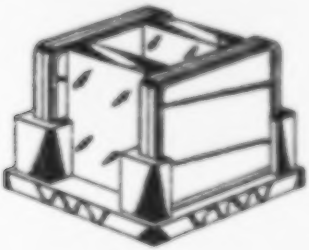
224,655
NOZZLE TIP FOR A DENTAL INSTRUMENT
William B. Dragan, R.F.D. Burr St., Fairfield, Conn. 06430
Filed Oct. 1, 1970, Ser. No. 25,298
Term of patent 14 years
Int. Cl. D24—*99*
U.S. Cl. D24—1

224,656
TAPE DRIVE OR SIMILAR ARTICLE
Albert J. Michaud, Jr., Marlboro, and John F. Graham, Sudbury, Mass., assignors to Honeywell, Inc., Minneapolis, Minn.
Filed Sept. 8, 1970, Ser. No. 24,888
Term of patent 14 years
Int. Cl. D14—*02*
U.S. Cl. D26—5

224,657
COMBINED GOLF BALL MARKER AND HOLDER
Janice M. Fisher, 1585 Chamber, St. Paul, Minn. 55106
Filed Aug. 28, 1970, Ser. No. 24,756
Term of patent 14 years
Int. Cl. D21—*02*
U.S. Cl. D34—5

Official Gazette Vol. 901, p.1504 A104

234,658
COMBINED COASTER SET, PLAYING CARD DECKS AND HOLDER THEREFOR
Richard H. Cole, Bloomington, and Erwin A. Freed, St. Paul, Minn., assignors to Minnesota Mining and Manufacturing Company, St. Paul, Minn.
Filed July 30, 1970, Ser. No. 24,328
Term of patent 14 years
Int. Cl. D21—01
U.S. Cl. D34—13

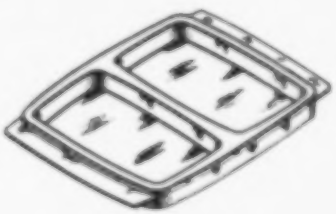


234,659
OPERABLE STAND FOR A MODEL AIRPLANE OR THE LIKE
Denis V. Bosley, Palos Verdes, Peninsula, and Larry R. Wood, Lawndale, Calif., assignors to Mattel, Inc., Hawthorne, Calif.
Filed Jan. 18, 1971, Ser. No. 107,610
Term of patent 14 years
Int. Cl. D21—01
U.S. Cl. D34—15

234,660
TOY MODEL AIRPLANE
David William Penney, Livingston, N.J., assignor to Childhood Promotions, Inc., Livingston, N.J.
Filed Jan. 26, 1971, Ser. No. 109,992
Term of patent 14 years
Int. Cl. D21—01
U.S. Cl. D34—15

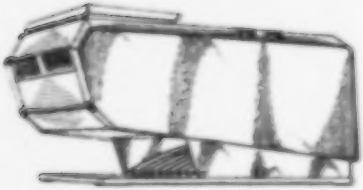
234,661
HOUSING FOR A TOY MUSIC BOX
Ernest L. Thorndl, Horicon, Wis., assignor to Marlin Toy Products, Inc., Horicon, Wis.
Filed Mar. 1, 1971, Ser. No. 119,990
Term of patent 14 years
Int. Cl. D21—01
U.S. Cl. D34—15

234,662
SERVING TRAY
James B. Sweet, Barrington, and Harold P. Ashton, Providence, R.I., assignors to Dart Industries Inc., Los Angeles, Calif.
Filed Aug. 24, 1970, Ser. No. 24,670
Term of patent 14 years
Int. Cl. D7—01
U.S. Cl. D44—15

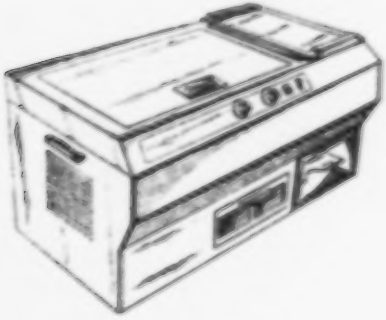


234,663
LEVEL
Maurice C. de Jong, Canton, Conn., assignor to The Stanley Works, New Britain, Conn.
Filed June 1, 1971, Ser. No. 149,186
Term of patent 14 years
Int. Cl. D10—05
U.S. Cl. D52—4

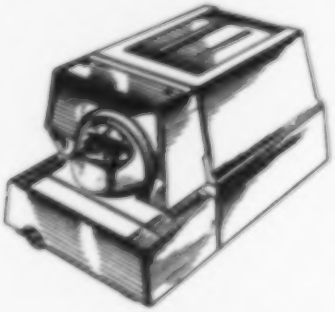
224,664
COPYING MACHINE
Georges Louis Joseph Peyret, 59 Rue Lamarck, Paris 18, France
Filed Sept. 1, 1970, Ser. No. 24,794
Claims priority, application France Mar. 19, 1970
Term of patent 14 years
Int. Cl. D16—03
U.S. Cl. D61—1



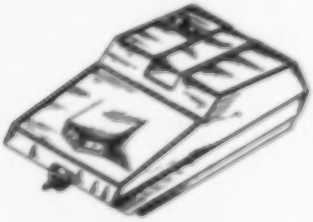
224,665
PHOTOCOPY MACHINE
Lionel B. Hoffman, Wyckoff, N.J., assignor to Pitney-Bowes, Inc., Stamford, Conn.
Filed Apr. 1, 1971, Ser. No. 130,556
Term of patent 14 years
Int. Cl. D16—03
U.S. Cl. D61—1



224,666
POSTAGE METER
Robert E. Schmeck, Old Greenwich, and Elmer W. Tangeri, Norwalk, Conn., assignors to Pitney-Bowes, Inc., Stamford, Conn.
Filed Jan. 19, 1971, Ser. No. 107,275
Term of patent 14 years
Int. Cl. D18—02
U.S. Cl. D64—11

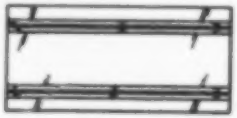


224,667
AIR-PUMP FOR AQUARIUM
Ryuzo Kondo, 972 Tamamukaito-machi, Ohta-ku, Tokyo, Japan
Filed Aug. 21, 1970, Ser. No. 24,536
Term of patent 14 years
Int. Cl. D15—02
U.S. Cl. D65—1

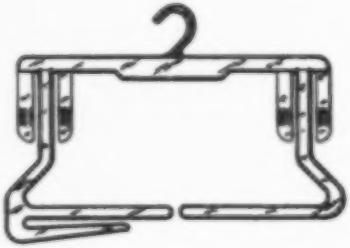


224,668
DECK PLUG
Francis J. Berger III, Kirkland, Robert L. Stevenson, Mercer Island, and Benjamin J. Lehman, Seattle, Wash., assignors to Lockheed Aircraft Corporation, Burbank, Calif.
Filed Nov. 20, 1970, Ser. No. 24,242
Term of patent 14 years
Int. Cl. D13—09
U.S. Cl. D71—1

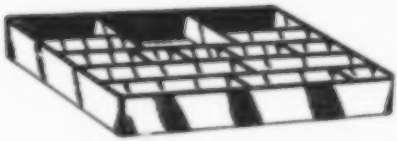
224,669
LETTER HOLDER
Marion K. Summers, W. Commerce St., Brownstown, Ind. 47220
Filed June 22, 1970, Ser. No. 23,616
Term of patent 14 years
Int. Cl. D19—02
U.S. Cl. D74—9



224,670
GARMENT HANGER
Robert L. Hart, Manhasset Hills, N.Y., assignor to W. R. Grace & Co., Duncan, S.C.
Filed Mar. 4, 1971, Ser. No. 121,223
Term of patent 14 years
Int. Cl. D6—03
U.S. Cl. D69—8

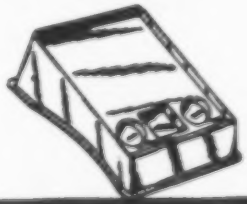


224,671
SURGICAL TRAY
Robert E. Eddy, 814 W. Jackson, Knoxville, Iowa 50138
Filed July 23, 1970, Ser. No. 24,874
Term of patent 3½ years
Int. Cl. D24—04; D24—99
U.S. Cl. D83—1

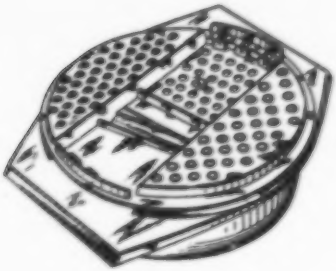


224,672
MYRINGOTOMY TUBE INSERTER
James L. Gerard, Cincinnati, Ohio, assignor to Xomed Corporation, Cincinnati, Ohio
Filed Nov. 2, 1971, Ser. No. 195,865
Term of patent 14 years
Int. Cl. D24—02
U.S. Cl. D83—12

224,673
SERVING TRAY FOR AUTOMOBILE SEATS
Riley H. Brooks, 1922 1st St., Webster City, Iowa 50595
Filed July 28, 1970, Ser. No. 24,187
Term of patent 14 years
Int. Cl. D7—07; D12—16
U.S. Cl. D87—1



224,674
COMBINED FOOD GRATER AND BOWL
Harold P. Ashton, Providence, and James B. Swett, Barrington, R.I., assignors to Dart Industries Inc., Los Angeles, Calif.
Filed Dec. 30, 1970, Ser. No. 26,784
Term of patent 14 years
Int. Cl. D7—04
U.S. Cl. D09—1



224,675
COMBINED SADDLEBAG AND BACKREST FOR A MOTORCYCLE OR THE LIKE
Verlin A. Hearn, 5662 Auburn Blvd., Sacramento, Calif. 95691
Filed Dec. 18, 1970, Ser. No. 26,563
Term of patent 14 years
Int. Cl. D12—16
U.S. Cl. D90—3

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Sup. Ct. Rule 19 .....

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Modern Art, New York", Museum of Modern Art in 19

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

FOREWORD

This is a commonplace action for patent infringement
n ordinary invalid design patent, in which the District
rt concluded that the subject matter of the patent in
was not obvious, and the Circuit Court, in reversing,
nimously concluded that it was obvious. This case meets
e of the criteria required by this Court as reasons for
ting review on certiorari as set forth in its Rule 19.

Petitioner, Hadco, has phrased its "QUESTIONS
ESENTED FOR REVIEW" in an attempt to conform
ese criteria. In actuality, however, the decision of the
uit Court for which review is sought, is not in conflict
any decision of any other court of appeals on the same
t, nor with the statutes, nor with the applicable deci-
s of this Court.

Chief Justice Taft's admonition set forth in *Keller v.*
as-Campbell Co., Inc., 264 U. S. 314, 319 (1924) applies
special force to the subject case:

"Such an ordinary patent case, with the usual issues
f invention, breadth of claims, and non-infringement,
his Court will not bring here by certiorari unless it be
ecessary to reconcile decisions of circuit courts of ap-
eal on the same patent."

Respondent, Kidde, accepts Hadco's statement of the
s, opinions, and judgments below, and jurisdictional
ds.

With regard to the statement of the case Hadco has
ated or twisted the record in many aspects. By way
ample, Hadco asserts "undisputed testimony" of
ersality of application" for the fixture of the patent

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in suit. This is based on the direct examination tes
of the patentee, Daum. On subsequent cross-exami
Daum conceded that *all* lighting fixtures are of u
application (Record 547a to 548a):*

> "A. *Of course, all fixtures are of universal*
> *cation if you want to put it on an application. It*
> *to the individual.* (Emphasis added.)

Indeed, he characterized as ridiculous any as
that either his fixture was unique in being of univer
sign, or that the prior art fixtures were not of u
design:

> "Q. . . . You didn't understand that as
> that your Tudor was of universal design, could b
> anywhere and these others could not and you
> determine it?
>
> "A. I didn't mean that way. I really didn
>
> "Q. I see.
>
> "A. *Because that would be ridiculous to*
> *statement like that.*" (Emphasis added.)

Parenthetically, Hadco's statement infers that
small company, which has been manhandled by
Actually, as reflected by the record, Hadco is a wholly
subsidiary of Esquire, Inc., a corporation on the Ne
Stock Exchange.

---

* Refers to the Joint Appendix Filed in Appeal to th
States Court of Appeals for the Third Circuit.

ARGUMENT

Question in This Case Is Worthy of Review.

The Design of the Patent in Suit Is a Trivial Obvious Departure From the Prior Art.

The patent in suit, Daum's Design Patent 199,143, ents a trivial obvious departure from the prior art. , the design constitutes a combination of elements, of which is present in the prior art. Daum testified what made the fixture of his patent interesting to the was its contour or silhouette, i.e. in his deposition DX-521a, he stated:

"Primarily, silhouette. That is what makes it interesting to the eye." (Emphasis added.)

A comparison of Kidde's prior art Item No. 5, No. 469, rimposed over the drawing of the patent application h issued as the patent in suit is set forth in the accom- ing Appendix. As the Circuit Court held, and as is diately evident, the prior art fixture is "quite similar e Hadco fixture in overall silhouette and contour").[1]

The minor details not present in this reference are, as Circuit Court found, clearly shown in the prior art.[2]

. [(A14) refers to page 14 of the Appendix to Petition for a of Certiorari to the United States Court of Appeals for the Third it.] While Hadco has dwelled on some of Kidde's secondary art references, even to the point of illustrating them in its Peti- it has studiously avoided in both its Petition and Appendix the superimposed comparison set forth in the accompanying Appen- hich was relied upon by the Circuit Court, A14. At the bottom e 9 of the Petition, Hadco refers to a "Christmas tree" effect. estly, if the silhouettes of the prior art fixture and of the ed fixture are similar, they must both resemble a "Christmas f either of them does so.

. The Circuit Court noted that while No. 469 is directed to a ded cage and a round roof, yet (A14):

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Viewed in a position most favorable to Hadco, these d
are, as the Circuit Court found "clearly recogniz
simple modifications".

Overall, the Circuit Court found (A18):

> "When viewed in light of the prior art, the
> lighting figure, on the contrary, appears simply
> attractive variation on a well-played theme. It
> not project the synergistic effect necessary to
> a patent for a design which is a combination
> and well-known elements. The differences in the
> lantern do not create such a new and unexpec
> sult in the appearance of the lighting fixture as a
> as to be a product of invention or of a skill b
> that of the ordinary designer in the art."

The great bulk of the Circuit Court's holding
based on documentary evidence, as to which it wa
bound by F. R. C. P. 52(a), *Deep Welding Inc. v. S
Bros., Inc.*, 417 F. 2d 1227, 1229 (7th Cir., 1969); *Dee
Bros. Inc. v. Buffalo Metal Container Corp.*, 352 F. 2
423 (2nd Cir., 1965); *Southern States Equipment Co
USCO Power Equipment Corp.*, 209 F. 2d 111, 117 (5
1953).

Kidde's expert witness, Robert Stith, was a d
of long experience (having designed custom lightin
tures before the First World War when the bulk
lighting fixtures were of custom design rather than
catalog or off the shelf items). He testified to the int

---

2. (Cont'd.)
"Almost identically to the Hadco lantern, however, the
though they appear round rather than hexagonal, curve in
as they rise, and flare out horizontally over the cages a
lower edges, terminating in a rippled design. Except for
four sided, the cages also are virtually identical to that
Hadco fixture in contour of silhouette."

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liarity of his generation of lighting fixture designers the components making up a lighting fixture of the set forth in the patent in suit, and how such designers sembled and restyled these well-known components to luce on demand a plethora of designs.[3]

The Circuit Court correctly found that it was within skill of such a lighting fixture designer to retain or de- these well-known components, or to modify their shape contour.

The Patent in Suit Being Directed to a Combination Must Meet the High Standards of Combination Patents.

The standards for combination patents have been set his Court in *Great Atlantic & Pacific Tea Co. v. Super- et Equipment Corp.*, 340 U. S. 147, 152 (1950); *Ander- -Black Rock, Inc. v. Pavement Salvage Co., Inc.*, 396 57, 61 (1969); and *United States v. Adams*, 383 U. S. 1966). These were precisely the standards which the nit Court followed, even to quoting from *A&P* and *rson's-Black Rock* (A7-8):

"Where, as in the present case, a combination patent is involved, additional aspects of nonobviousness come

3. Hadco misstates Stith's testimony in its Petition. By way ample, at page 13, it faults the Circuit Court for stating that ped rippled borders with indented triangle accents were fre- ly placed on the lower edges of roofs and vent caps as shown in tent in suit, asserting that Stith's testimony regarding the prior lated only to a sinuous curve. However, as reference to A66 s clear, Stith was testifying *precisely* as to the structure shown gure 1 of the patent in suit (A66):

"Q. Now, in connection with roofs of that period used on nterns, was it common to have the peripheral edge of the roof avy with a sinuous curve *as shown in Figure 1 of the patent suit?* (Emphasis added)

"A. It was frequently done because it was, I think, the heapest and easiest decoration that could be put therein."

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into play. The court must 'scrutinize combi
patent claims with a care proportioned to the dif
and improbability of finding invention in an ass
of old elements.'[18] Such a patent must create a
gistic effect, one in which the combination of el
results 'in an effect greater than the sum of the s
effects taken separately.'[19]"

"18. *Great Atlantic & Pacific Tea Co. v. Super
Equipment Corp.*, 340 U. S. 147, 152 (1950).

"19. *Anderson's-Black Rock, Inc. v. Pavement S
Co., Inc.*, 396 U. S. 57, 61 (1969); *United States v. A
383 U. S. 39 (1966)."

**It Is Specious to Argue That Under the Stan
Established by the Court of Appeals, No Des
Patentable.**

Hadco asserts that under the standards of the C
Court it is not possible to sustain the validity of any d
patent. This assertion is hypothetical and not a p
question for review. Moreover, the assertion is simpl
true.

Both the District and Circuit Courts applied e
tially the same standard. At no time heretofore did H
assert that the standard is too strict or improper.

What is involved in the case at bar is a design
differs from the prior art by mere trifles. Such desig
far short of the Constitutional standard.[4]

A collection of designs, many of which would me
constitutional standard, is set forth in The Design C

4. Hadco appears to seek a separate standard for design
is followed by other patents, notwithstanding that there is a
constitutional standard for all patents be they for mechanical d
designs or plants. Moreover, 35 U. S. C. 171 explicitly pr
that the patent statutes relate to design patents as well as to
patents. If this is to be changed, it should be done by constitu
amendment and legislative reform, and not by court decision,
Cullough v. Maryland, 4 Wheat. 316 (1819). Patent right
only by virtue of statute, *Wheaton v. Peters*, 8 Pet. 591, 658 (1

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of the New York Museum of Modern Art, a portion of
h is displayed in its Philip L. Goodwin Galleries of
itecture and Design.

Many of these pieces are shown in the book entitled:
e Design Collection, Selected Objects, The Museum of
ern Art, New York" published by the Museum of
ern Art in 1970. This book's preface reads in part:

"The Design Collection of The Museum of Modern Art was established in 1934 and now includes over 1,800 mass-produced or handmade objects. They have been selected on the basis of their quality and historical significance to illustrate the development of design during the past seventy-five years.

"Some 125 of these objects—including household and office appliances, tableware, tools, and furniture—are continuously exhibited in the Philip L. Goodwin Galleries, opened in 1964 and named in honor of the architect who from 1935 to 1940 was chairman of the Museum's Department of Architecture and Industrial Art. This international selection presents both an historical survey of styles, from Art Nouveau to the present, *and a standard of reference for judging contemporary design.*" (Emphasis added.)

The book illustrates such outstandingly inventive de-
s as the Charles Eames lounge chair and ottoman, Eero
rinen molded plastic armchair, Mies van der Rohe
ge chair, Frank Lloyd Wright desk, Nizzoli design for
Olivetti typewriter, and inventive designs in a folding
phone, coffee grinder, lamp, portable radio, control
el for an IBM 305, etc.[5] Many of these designs conform

5. A photograph of a portion of the Philip L. Goodwin Galleries
Architecture and Design is set forth in the accompanying Ap-
ix.

to the standard of the Constitution, and promote progress of the useful arts. In contrast, the patented sign simply constitutes a slight variation from the p art, easily within the skill of an ordinary worker in the or ordinary designer.

Hadco Would Have This Court Withdraw From Constitutional Standard and Adopt the Stan of the Patent Office.

At page 22 of its Petition, Hadco bemoans that Patent Office continues to accept design applications a issue about three thousand design patents every ye unsuspecting inventors who are led to believe that they receiving protectable rights".[6]

Hadco's apparent solution for this alleged proble to have this Court abandon the Constitutional standard adopt that of the Patent Office.

Manifestly, the subject situation is a clear case of this Court has termed "the notorious difference bet the standards applied by the Patent Office and by courts", i.e. *Graham v. John Deere Co.*, 383 U. S. 1, 1 (1966):

> "We have observed a notorious difference betwee standards applied by the Patent Office and by courts.
>
> * * *
>
> "Although we conclude here that the inquiry w the Patent Office and the courts must make as to pa

6. As set forth in the book *The Design Collection*, quoted f the Museum of Modern Art has selected 1,800 designs as m the "standard of reference for . . . design" for the past seven years. This 1,800 designs in seventy-five years contrasts wi Patent Office issuing "about three thousand design patents year."

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ility must be beamed with greater intensity on the quirements of § 103, it bears repeating that we find change in the general strictness with which the over- test is to be applied. We have been urged to find in 103 a relaxed standard, supposedly a congressional action to the 'increased standard' applied by this ourt in its decisions over the last 20 or 30 years. The andard has remained invariable in this Court."

he Presence of Secondary Factors, Such as Commercial Success, Will Not Make for Patentability Without Invention.

he District Court was overly impressed by the alcommercial success of the design of the patent in suit. ver, secondary factors, such as commercial success, lfillment of long-felt need, cannot make up for the e of invention. The Circuit Court gave measured t[7] to all of these secondary considerations, and deed that invention was plainly lacking (A20):

Under the mandate of *John Deere, supra,* this court as given measured weight to secondary considerations such as commercial success, the opinion of other anufacturers in the pertinent art, and the fulfillment f long-felt need.[50] In determining the validity of a esign patent, however, the primary target of inquiry emains the design itself, and the presence of secndary factors 'without invention will not make

"50. *Philips Electronic and Pharmaceutical Industries orp. v. Thermal and Electronic Industries, Inc.,* 450 F. 2d 164, 1174 (3 Cir. 1971); *Frank W. Egan & Company v. Modern Plastic Machinery Corp.,* 387 F. 2d 319, 324 (3 Cir., 967) *cert. den.* 361 U. S. 883 (1959).

Hadco's statement at page 7 of its Petition that the Circuit rejected these secondary considerations as "altogether irrele- is a gross misstatement of the record.

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patentability.'[51] Having concluded that the d
itself is not a product of invention, it cannot be
tained as nonobvious on the basis of other seco
considerations. 'Where . . . invention is p
lacking, commercial success cannot fill the void

"51. *Anderson's-Black Rock, Inc. v. Pavement S
Co., Inc.*, 396 U. S. 57, 61 (1969); *E. J. Brooks Com
Stoffel Seals Corp.*, 266 F. 2d 841, 844 (2 Cir., 1959).

"52. *Jungersen v. Ostby & Barton Co.*, 335 U. S
567 (1949)."

CONCLUSION

The petition should be denied.

Respectfully submitted,

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Appendix

THE PATENTEE DAUM DEFINED THE ESSE HIS DESIGN AS:

> **"PRIMARILY, SILHOUETTE. THAT IS MAKES IT INTERESTING TO THE EYE."**

SEE PAGES 3 AND 4, SUPRA.

Figure 1 of Daum Patent Application Drawing, DX-191, imposed Over Prior Art Herwig Fixture, DX-220, Ref in Opinion of Circuit Court as "Kidde's Item No. 5, M See Footnote 35 to Opinion of Circuit Court at A1 Principal Differences in Contour Between the Two I Are Due to Errors in the Drawings of the Daum Paten cation, Namely the Outside Simulated Ventilators, Whic Conceded Should Not Be on the Drawings, See Footn Circuit Court's Opinion at A3.

Photograph Showing Portion of Designs on Display a
Philip L. Goodwin Galleries of the New York Mus
Modern Art, Which Meet a High Standard, See Page 7
Among the Designs Shown in the Photograph Are: Pu
Helmet, Pail, Pots, Ice Cream Scoop, Telephone, Chair,
and Table.

(15)

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FILED
OCT 31 1972
MICHAEL RODAK, JR., CLERK

IN THE

preme Court of the United States

October Term, 1972.

No. 72-423.

HADCO PRODUCTS, INC.,
Petitioner,

v.

WALTER KIDDE & COMPANY,
Respondent.

PLY BRIEF AND APPENDIX FOR PETITIONER.

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IN THE

Supreme Court of the United States.

OCTOBER TERM, 1972.

No. 72-423.

HADCO PRODUCTS, INC.

Petitioner,

v.

WALTER KIDDE & COMPANY,

Respondent.

EPLY BRIEF AND APPENDIX FOR PETITIONER IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT.

INTRODUCTION.

Petitioner seeks the Court's exercise of its sound judi-l discretion to issue the writ of certiorari in this case on o grounds set forth in Rule 19(b) of the Supreme Court ules; namely, because the Court of Appeals decision 11) is in express disagreement with decisions of the ourt of Customs and Patent Appeals and the Court of ppeals for the Ninth Circuit, and because the decision oses important questions of federal law which should be ttled by the Supreme Court.

THE COURT OF APPEALS DECISION IS IN CONF WITH DECISIONS OF THE COURT OF CUS AND PATENT APPEALS AND THE COUR APPEALS FOR THE NINTH CIRCUIT.

Conflict between the decision of the Court of A and the Court of Customs and Patent Appeals and th Circuit involves the specific manner in which the patentability set forth in § 103 of the Patent Act is applied to design patents. More particularly, it in the question of who, in the case of a design invent the mythical "person of ordinary skill" to which the makes reference, as well as the much broader quest to whether any design patent can meet the non-obvio qualification as interpreted and expounded in *Grah John Deere Co.*, 383 U. S. 1, 6 (1966).

The Court of Appeals' Opinion is openly critical District Judge for being influenced by the decision Court of Customs and Patent Appeals in *In re Lan* 356 F. 2d 1003; 53 C. C. P. A. 1158 (1966) which was lowed by the Ninth Circuit in *Schwinn Bicycle Co. v. G year Tire & Rubber Co.*, 444 F. 2d 295 (9 Cir., 1970). deed, the District Judge's decision was reversed prec on a point involving the meaning and application of More recently, the split of authority among the Court Appeals has come into sharper focus with the very re (October 16, 1972) decision in the Court of Appeals of District of Columbia in *Murray Fields v. Schuyler*, — 2d — (1972), which makes reference to the *Hadco, Lane Schwinn* and *John Deere* decisions and speaks of "the sible need for a different gloss on the obviousness stan in the case of design patents".[1]

1. This decision adds to the long list of post *John Deere* de cases in which the courts have uniformly found the designs u unpatentable.

ESPONDENT ITSELF RAISED THE CONSTITUTIONAL QUESTION IN THIS CASE.

While the case was pending before the District Court, spondent formally notified the Court and the Attorney neral of the United States that it would challenge the nstitutionality of the Design Patent Statute, 35 U. S. C. 1. In successfully seeking reversal of the judgment from e Court of Appeals, Respondent, in its brief before that urt, challenged the constitutionality of the Design Patent t (Brief for Appellant, p. 35):

> "In *Graham v. John Deere Co.*, 383 U. S. 1, 6, the Supreme Court, in discussing the import of Article 1, Section 8, clause 8 of the Constitution, reiterated the fundament:
>
> 'Innovation, *advancement,* and *things which add to the sum of useful knowledge* are inherent requisites in a patent system which by constitutional command must 'promote the progress of . . . useful Arts.' (Emphasis added.)'
>
> • • •
>
> If indeed the more subjective considerations of the District Court are proper under the controlling statutory mandate providing for design patents, 35 U. S. C. 171, then Kidde submits that such statute is unconstitutional. Its unconstitutionality is first shown by its apparent disregard of the requirement of promoting 'the progress of . . . useful Arts' as set forth in the explicit language of the Constitution. The statute so construed would also suffer from an unconstitutional vagueness since 'one's subjective appraisal' defies orderly definition.
>
> Perhaps Kidde's position is best stated by the following comment, which followed the Supreme Court decision of *Graham v. John Deere Co.*, at Note, *The 1966 Patent Cases: Creation of a Constitutional Standard,* 54 Geo. L. J. 1320, 1337-1339 (1966):
>
> 'The Court, the Congress, and the profession thought design patents constitutionally permissible for over one hundred years. Yet, the subject matter of design patents does not add to the sum of useful knowledge now deemed by the Court to be constitutionally required. The conclusion is inevitable—either the design patent statute is

> unconstitutional or the Court's constitutional requir
> of an advancement is incorrect.'
>
> The District Court erred by not satisfying the co
> tional standards for patentability in finding the patent i
> unobvious. If the standard applied by the Court was p
> such standard is unconstitutional."

The Court of Appeals, responding to the above a
ment that *Graham v. John Deere* set forth a higher co
tutional standard differing from and superseding the Pa
Statute, interpreted § 103 as requiring "synergism" in
sign cases as in mechanical cases. On this basis, the pa
in suit was found to be invalid. The same end resul
holding of invalidity—has been achieved in every d
patent case to reach a Court of Appeals since the decisi
Graham v. John Deere Co., supra. Indeed, as appears fr
the appended communication from Respondent's co
to the Court of Appeals, submitted after argument a
prior to the decision, this very point was emphasized a
principal reason for holding the Daum patent invalid. T
net effect is that Graham v. John Deere has been constr
and applied by the Courts of Appeals to nullify the d
patent statute in toto.

RESPONDENT MISREPRESENTS THE EVIDENCE.

At page 12 of Respondent's Brief it is stated:

"The patentee Daum defined the essence of his design as:

> 'Primary, silhouette. That is what makes it interesting to the eye.'"

This statement is false and the Daum quotation is taken out of context. Daum was not asked to define the "essence of his design." He was asked by Respondent's counsel on deposition to state whether everything shown in solid lines in his patent was novel and invented by him, to which he answered affirmatively. He then described the novel feature of his design, which included the "general proportions of the whole entire design" for which Respondent's counsel substituted the word "silhouette."

At the trial, Respondent's counsel attempted to define the quoted Daum testimony regarding the "silhouette" of the design as meaning a two-dimensional outline without more. Mr. Daum unequivocally rejected the suggestion that the primary feature of his design was a two-dimensional outline of the lighting fixture. He repeatedly insisted, as he had in his deposition, that when he used the term "silhouette" he meant the overall shape of the lighting fixture characterized by a six-sided roof and a six-sided lantern with a unique "Christmas tree" appearance. It is equally clear that the statement presented at page 12 of Respondent's Brief entirely misrepresents Mr. Daum's testimony in that it sets forth as his testimony that which he repeatedly refused to accept. His testimony on deposition and at the trial, attached in the Appendix hereto, fully supports this fact as does the following excerpted statement by Mr. Daum (521a-523a):

"Q. And you used before that the word pri
primarily silhouette. Is one of the most imp
things about your fixture its silhouette when it is
lighted against the sky, for example, with the
back of it. Its silhouette against the sky, is that
the important things about your fixture visually?"

"A. No, no."

Respondent's purpose in seeking to commit the
ventor Daum to the proposition that his design is prim
characterized by a specific two-dimensional outline of
lighting fixture was to justify a comparison of two-
sional representations of one view of the Daum des
the prior art lantern of Herwig No. 469.

At page 13 of Respondent's Brief appears wh
ports to be Figure 1 of the design patent in
imposed over the Herwig fixture, the chief item of th
art relied upon by Respondent. The impression
to be conveyed by this superimposition is that the
of the Daum design is identical to the silhouette of
fixture No. 469. The comparison is illusory because
sents a fragmented two-dimensional line drawing
imposed upon a three-dimensional photographic rep
tation. This illusion of identity figured prominently
in persuading the Court of Appeals that the Daum
patent was invalid.

In order to enable the Court to make a true compar
between the two designs presented by Respondent the
presented on the following pages two photographs,
showing at the right side an actual fixture made under
Daum patent in suit, and at the left side a fixture in all
spects similar to the Herwig catalog item No. 469
Respondent has selected as most pertinent. It is im
ately apparent that the mutilation of the Daum desig
presented in Respondent's Brief, eliminating the finial

HERWIG NO. 469 HADCO

HERWIG NO. 469 HADCO

portions of the vent cap of the Daum lighting fixture, removes dramatic points of difference between the two fixtures. It is also evident from a comparison of Respondent's Brief with the photographs that Respondent has heightened the illusion of similarity by altering the relative sizes of the two fixtures to produce the same scale. Scale is an important aspect in all design. It becomes very clear from the photographs that there is no significant similarity between the roof portions of the two fixtures and that the hexagonal cage of the patent is altogether different from the "cylindrical" cage of the Herwig fixture. (See the descriptive matter in the catalog pertaining to item No. 469.)

The Daum design is characterized by the very striking angularity of the finial, vent cap, roof, and cage, as is clearly shown in Figure 2 of the Daum patent, whereas, in the Herwig fixture, all elements, from top to bottom, are circular in cross section. The roof edges of the Daum design not only rise and fall in their sinusoidal curvature but have triangular accents raised out of the normal plane of the roof and forming a distinctive pattern. By contrast, the roof of the Herwig fixture is simply notched at its peripheral edge to form semi-circular serrations in the plane of the roof. The representation of the Herwig fixture in Respondent's Brief by reason of its vagueness of illustration gives a false impression as to the true character of the roof edge treatment.

The suggestion of identity of the cage elements of the two fixtures in Respondent's altered representations is clearly erroneous and quite misleading.[2] As the catalog

2. Both opinions below mistakenly refer to Herwig fixture No. 469 as having a "four sided" cage (A 14, A 30). Actually, all parts thereof are round, as evidenced by the catalog description and by the appended testimony of Daum. The photographs herein confirm what the roof and cage of the Herwig fixture would look like if viewed in perspective.

states, the Herwig cage is "cylindrical" with four verti framing elements, whereas the cage in the Daum desig hexagonal and flat between the six vertical framing ements. In fact, the photographs amply justify the D trict Judge's characterization of the prior art as "squat (A 34) as compared to the Daum design.

It is apparent that the dramatic silhouette compari of the Daum design with the prior art which has been important part of Respondent's position throughout t case is based upon an *incomplete* and *misleadi* presentation.

Inherent in the decision below and in numerous ca rendering design patents invalid, either upon summa judgment or upon reversal of the District Court judgme of validity, is the abandonment of reliance upon evidentia findings of fact dealing with level of skill and obvious in design patent cases.

PROPER ADMINISTRATION OF THE DESIGN PA ENT SYSTEM REQUIRES DECISION BY TH COURT.

Respondent would persuade the Court that this is "commonplace action" and "an ordinary patent case This is not, however, the position Respondent took befo the Courts below. On the contrary, Respondent served t appended formal notice upon the Courts and upon t Attorney General of the United States that the constit tionality of the design patent law was at stake.

The only way in which the term "commonplace" c be applied to the present case is in that it has becom commonplace for the Courts of Appeals to invalidate desi patents. Since the decision of the Supreme Court *Graham v. John Deere Co., supra,* the invalidation of desi patents has in fact become so commonplace as to ca

both Respondent and the District Court to question whether any design can be found patentable under the Constitution.

It is quite clear that the Court of Appeals, in reversing the District Court and holding the Daum patent invalid, was conscious of the questions that have been raised regarding the demise of design patents (A 12, fn. 29). The District Court flatly questioned whether any design patent could be constitutional. No Court of Appeals has held a design patent valid since the decision of *Graham v. John Deere*. Still, inventors continue to rely upon the promise offered by the design patent statute and by the Patent Office in administering that statute. The question that has been raised deserves an answer at this time.

Respectfully submitted,

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Appendix.

NOTICE UNDER RULE 44.

UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

APPEAL No. 19,068

WALTER KIDDE & CO., INC.,
Appellant

v.

HADCO PRODUCTS, INC.,
Appellee

Notice Under Rule 44 of the Federal Rules of Appellate Procedure.

Pursuant to Rule 44 of the Federal Rules of Appellate Procedure, Walter Kidde & Co., Inc., the above-named appellant, hereby gives notice that it will draw into question the constitutionality of 35 U. S. C. § 171, in the above-captioned appeal.

Respectfully submitted,

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LETTER TO THE CLERK OF THE U. S. COURT APPEALS FOR THE THIRD CIRCUIT.

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2046 U. S. Court House
Philadelphia, Penna. 19107

Re: Hadco Products, Inc. v. Walter Kidde & Company, Appeal No. 19068 in the United States Court of Appeals for the Third Circuit

Dear Mr. Quinn:

On April 2, 1971, the above-identified appeal was ar to the Court of Appeals, Judges Seitz, Forman and Aldi

No decision has as yet been rendered by the Court of Appeals.

At footnote 2 on page 4 of appellant's Reply Brief, there is a listing of all of the Court of Appeals decisions dealing with design patents subsequent to *Graham v. John Deere Co.* Without exception, each such Court of Appeals decision has held the patent in suit to be invalid.

I have just learned that on March 16, 1972, the Court of Appeals for the Seventh Circuit in *Frantz Mfg. Co. v. Phenix Mfg. Co.* held invalid design patent 194,094. This decision has not yet been reported. This patent had previously been held valid by the United States District Court for the Eastern District of Wisconsin in *Frantz Manufacturing Co. v. Phenix Manufacturing Co.*, 307 F. Supp. 99 (E. D. Wisc., 1970).

Accordingly, the Court of Appeals decision of the Seventh Circuit should be added to the aforesaid footnote 2.

I am enclosing herewith a copy of this letter for each of Judges Seitz, Forman, and Aldisert.

A copy of this letter has been delivered to Woodcock, Washburn, Kurtz & Mackiewicz, Esqs., attorneys for appellee.

Respectfully submitted,

ARTHUR H. SEIDEL,
Arthur H. Seidel,
Attorney for Appellant.

AHS:c
cc: Robert B. Washburn, Esq.

EXCERPTS FROM DAUM TESTIMONY.

H. A. DAUM—DIRECT.

(464a)

The Witness: Murlin. Nothing fulfills the req ment there.

19, the same; 20, the same; 21, the same; 22, 2 the same; 25, the same; 26, the same; 27, the same

By Mr. Paul:

Q. Stop for a moment at 27.

Are you personally familiar with the Herwig fix that are shown on Page 27 in this book?

A. I certainly am.

Q. Let me call your attention on Page 26 to No. at the left. Do you see that?

A. Yes.

Q. And to Nos. 469 and 470 on Page 27.

A. Yes.

Q. Are you familiar with those particular fixtures

A. They are the same fixtures.

Q. What is the shape of the roof?

A. Round.

Q. What is the shape of the cage?

A. Round.

Q. The cage?

A. Is round.

Q. Oh! How many sides to it.

A. It has four divisions in a round circle.

(465a)

Q. But they are mounted in a circle, are they not?

A. It tells you right here. It says 4½ inches. cylinder size is 2½ by 5½ by 5¾, and that's a cone-sha cylinder.

Q. Then the cage?

A. The cage is definitely a cylinder too.

Q. The roof is conical?

A. The roof is conical in shape (indicating).

Mr. Seidel: Your Honor——

The Witness: And it is round.

Mr. Seidel: What he just testified to, it's impossible. A cylinder, as I understand it, is a solid of constant diameter. That can't possibly have a constant diameter, Mr. Paul.

The Court: Under 470 and describing it, it says: "Cylinder size 2½ by 5½ by 5¾."

The Witness: It gives three dimensions.

Mr. Seidel: That's a misuse of the word cylinder if there ever was one, Your Honor, because a cylinder is a constant diameter.

The Court: I didn't print the book, and neither did you.

Mr. Seidel: O. K. Thank you.

* * *

H. A. Daum—Cross.

* * *

(521a)

how many years would you say? Twenty, thirty years?

A. I would say somewhere in there.

Q. Would you say that is an unusual length of time for an outdoor fixture to be sold, the same style?

A. No, not necessarily.

Q. What?

A. Not necessarily.

Q. Not necessarily.

Now, in your testimony at—I will give you the pag
counsel can verify—Page 170 of your deposition of Sep
ber 9, 1969, you stated, and I will refresh your recollect

"Silhouette—and you were then referring to y
fixture as shown in your patent—silhouette, th
what makes it interesting to the eye."

Do you recall that statement?

A. Yes, I do.

Q. And you used before that the word primarily,
marily silhouette.

Is one of the most important things about your fi
its silhouette when it is highlighted against the sky,
example, with the sun in back of it? Its silhouette ag
the sky, is that one of the important things about your
ture visually?

(522a)

A. No, no.

Q. Well, what did you mean by: "Primarily silhou
that's what makes it interesting to the eye"?

A. Can I answer that?

Q. Yes.

A. It was the general shape, the contour shape wh
used the word possibly improper for an attorney.

I use it as a silhouette giving a shape to that thing
lar to, or if you want to call it, a Christmas tree, if
want to call it that, but I did not design the silhouette
I designed a silhouette, then we would have had a
fixture, and that would have been all there was to it.

Q. By "silhouette," do you mean profile, the ou
configuration?

A. Yes.

Q. That's important?

A. Yes, that shape.

Q. That outside shape?

A. Its shape, that's part of——

Q. You will agree with me that if somebody was at a distance and couldn't see the details such as the triangular accents at the periphery of the roof or the triangular accents at the periphery of the vent cap or the simulated ventilators, and if there was a bright light in back of the fixture such as

* * *

(523a)

the sun, they could see the profile of the fixture or the silhouette of the fixture? That's what you are talking about, isn't it?

A. Can I answer that?

Q. Yes.

A. I mean in my own words, without saying yes or no?

Q. First give the answer to my question and then you can qualify it if you like.

A. I don't agree with your question.

Q. You don't agree with that?

A. No.